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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

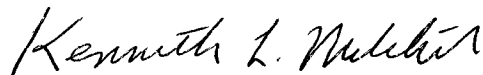
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
Before The Trademark Trial and Appeal Board

Pucel Enterprises, Inc.	)	
1440 E. 36th Street	)	
Cleveland, OH 44114	)	
	)	
Opposer-Petitioner	)	CONSOLIDATED
	)	
v.	)	Opposition No. 91123506
	)	Cancellation Nos. 92031984;
	)	92032024; 92032025
Grizzly Industrial, Inc.	)	
1821 Valencia Street	)	
Bellingham, WA 98226	)	
	)	
Applicant-Respondent	)	
	)	

OPPOSER-PETITIONER PUCEL'S TRIAL BRIEF

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2,413,625 FOR THE MARK **GRIZZLY**®

(d) CORRELATION OF OPPOSER-PETITIONER'S PUCEL'S <b>GRIZZLY</b> ® AND <b>GRIZZLY BEAR SYMBOL</b> ® REGISTRATIONS AND OTHER GOODS AND SERVICES TO APPLICANT-RESPONDENT'S UNITED STATES TRADEMARK REGISTRATION NO. 2,312,226 FOR THE MARK <b>GRIZZLY INDUSTRIAL</b> ®	26
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### **C. IDENTIFICATION OF PARTIES, TESTIMONY AND EXHIBITS**

#### **PUCEL IS IN POSITION OF PLAINTIFF**

OPPOSER-PETITIONER is Pucel Enterprises, Inc., of Cleveland, Ohio, a United States manufacturer sometimes referred to hereinafter "PUCEL."

Trial Depositions testimony of OPPOSER-PETITIONER PUCEL include the deposition of Robert Mlakar identified as (O/P PUCEL RM TR. DEPO pp \_\_\_\_ ) and Anthony Mlakar identified as (O/P PUCEL AM TR. DEPO pp \_\_\_\_ ). OPPOSER'S-PETITIONER'S trial exhibits will be designated as (O/P PUCEL TR. EXH. \_\_\_\_ ).

Discovery Depositions of OPPOSER-PETITIONER PUCEL include the deposition of Robert Mlakar identified as (O/P PUCEL RM D. DEPO pp \_\_\_\_ ) and Anthony Mlakar identified as (O/P PUCEL AM D. DEPO pp \_\_\_\_ ). OPPOSER'S-PETITIONER'S discovery deposition exhibits will be designated as (O/P PUCEL D. DEPO EXH. \_\_\_\_ ).

#### **GRIZZLY INDUSTRIAL IS IN POSITION OF DEFENDANT**

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL is Grizzly Industrial, Inc., Bellingham, Washington, an importer sometimes referred to hereinafter "GRIZZLY INDUSTRIAL."

Trial Depositions of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL include the deposition of Shiraz Balolia identified as (A/R GRIZZLY INDUSTRIAL SB TR. DEPO pp \_\_\_\_ ) and Sidney Levy identified as (A/R GRIZZLY INDUSTRIAL SL TR. DEPO. pp \_\_\_\_ ). APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S trial exhibits will be designated as (A/R GRIZZLY INDUSTRIAL EXH. \_\_\_\_ ).

The Discovery Deposition of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL includes the deposition of Shiraz Balolia identified as (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp \_\_\_\_ ). APPLICANT'S-REGISTRANT'S discovery deposition exhibits will be designated as (A/R GRIZZLY INDUSTRIAL D. DEPO EXH. \_\_\_\_ ).

#### **D. INTRODUCTION**

OPPOSER-PETITIONER PUCEL is an Ohio corporation started by Edward Pucel in 1949. Mr. Pucel died in 1980 at which time Mr. Anthony Mlakar became President of the Ohio. Previously, beginning in 1961, Mr. Anthony Mlakar served as the accountant for PUCEL. Mr. Robert Mlakar is Vice President and has worked at PUCEL since 1978 when he was 15 years old and still in high school.

**GRIZZLY<sup>®</sup> EQUIPMENT**, has been manufactured since 1949 and is currently manufactured by OPPOSER-PETITIONER PUCEL in Cleveland, Ohio. All material handling and industrial products sold have been marked and labeled **GRIZZLY<sup>®</sup> EQUIPMENT** MFG. BY PUCEL (O/P PUCEL RM TR. DEPO pp-15, 18, 19 -several ), (O/P PUCEL AM TR. DEPO pp 60-63), (O/P PUCEL TR. EXH. 53).

OPPOSER-PETITIONER PUCEL owns U.S. Trademark Registrations 704,631; 704,530 and 704,588 (O/P PUCEL TR. EXH. 2, 4, 6) all for the **GRIZZLY BEAR<sup>®</sup> symbol** and U.S. Trademark Registrations 624,055; 704,529 and 704,589 are all for the word mark **GRIZZLY<sup>®</sup>** (O/P PUCEL TR. EXH. 1, 3, 5) reproduced below on the next page. The goods recited in the **GRIZZLY<sup>®</sup>** word mark registrations 624,055; 704,529 and 704,589 are identical to goods recited in the **GRIZZLY BEAR<sup>®</sup> symbol** registrations 704,631; 704,530 and 704,588. OPPOSER-PETITIONER PUCEL sells all the goods recited in the registrations (O/P PUCEL TR. EXH.1-6) and additional goods not recited in the registrations. The goods are material handling and industrial equipment for use in a wide variety of industries and for personal use.

Mr. Robert Mlakar and Mr. Anthony Mlakar testified the **GRIZZLY<sup>®</sup>** and the **GRIZZLY BEAR<sup>®</sup>** symbol has been used as long as they have been associated with the company in any capacity. (O/P PUCEL RM TR. DEPO pp 12-22; O/P PUCEL AM TR. DEPO pp 1-12).

OPPOSER-PETITIONER PUCEL opposes registration of the word mark **GRIZZLY.COM** (Serial No. 76/088,346 O/P PUCEL TR. EXH. 7) by APPLICANT-RESPONDENT GRIZZLY



Int. Cl.: 20

Prior U.S. Cl.: 32

United States Patent and Trademark Office

Reg. No. 624,055

Registered Mar. 27, 1956

10 Year Renewal

Renewal Term Begins Mar. 27, 1966

TRADEMARK  
PRINCIPAL REGISTER

*Grizzly*

PUCCEL ENTERPRISES, INC. (OHIO  
CORPORATION)  
1440 EAST 36TH STREET  
CLEVELAND, OH 44114

FOR: SHOP EQUIPMENT—NAMESLY,  
TABLES, BENCHES, CABINETS,

RACKS, SHELVES, STANDS, DESKS,  
AND PARTS THEREOF, IN CLASS 32  
(INT. CL. 20).

FIRST USE 8-2-1951; IN COMMERCE  
11-21-1951.

SER. NO. 71-689,517, FILED 6-14-1955.

United States Patent Office

704,529

Registered Sept. 20, 1960

PRINCIPAL REGISTER  
Trademark

Ser. No. 91,447, filed Feb. 23, 1960

*Grizzly*

Pucel Enterprises, Inc. (Ohio corporation)  
3746 Kelley Ave.  
Cleveland 14, Ohio

For: BOX TRUCKS, DUMP TRUCKS, HAND  
TRUCKS, DOLLIES AND WHEELED PLATFORMS,  
WHEELED RACKS AND WHEELED TABLES, in  
CLASS 19.

First use Mar. 9, 1953; in commerce June 22, 1953.

# United States Patent Office

704,589  
Registered Sept. 20, 1960

## PRINCIPAL REGISTER Trademark

Ser. No. 91,448, filed Feb. 23, 1960

*Grizzly*

Pucel Enterprises, Inc. (Ohio corporation)  
3746 Kelley Ave.  
Cleveland 14, Ohio

For: DRUM LIFTERS, TILTING ARCS, DRUM  
CRADLES, DRUM UP-ENDERS, AND HOIST  
HOOKS, in CLASS 23.  
First use Apr. 23, 1951; in commerce Sept. 21, 1951.

# United States Patent Office

704,530  
Registered Sept. 20, 1960

## PRINCIPAL REGISTER Trademark

Ser. No. 91,450, filed Feb. 23, 1960



Pucel Enterprises, Inc. (Ohio corporation)  
3746 Kelley Ave.  
Cleveland 14, Ohio

For: BOX TRUCKS, DUMP TRUCKS, HAND  
TRUCKS, DOLLIES AND WHEELED PLATFORMS,  
WHEELED RACKS AND WHEELED TABLES, in  
CLASS 19.  
First use Mar. 9, 1953; in commerce June 22, 1953.

# United States Patent Office

704,631  
Registered Sept. 20, 1960

## PRINCIPAL REGISTER Trademark

Ser. No. 91,446, filed Feb. 23, 1960



Pucel Enterprises, Inc. (Ohio corporation)  
3746 Kelley Ave.  
Cleveland 14, Ohio

For: SHOP EQUIPMENT--NAMESLY, TABLES,  
BENCHES, CABINETS, RACKS, SHELVES, STANDS,  
DESKS AND PARTS THEREOF--in CLASS 32.  
First use Aug. 2, 1951; in commerce Nov. 21, 1951.

# United States Patent Office

704,588  
Registered Sept. 20, 1960

## PRINCIPAL REGISTER Trademark

Ser. No. 91,445, filed Feb. 23, 1960



Pucel Enterprises, Inc. (Ohio corporation)  
3746 Kelley Ave.  
Cleveland 14, Ohio

For: DRUM LIFTERS, TILTING ARCS, DRUM  
CRADLES, DRUM UP-ENDERS, AND HOIST  
HOOKS, in CLASS 23.  
First use Apr. 23, 1951; in commerce Sept. 21, 1951.

INDUSTRIAL and petitions for the cancellation of three (3) registrations, two (2) of which are for the word mark **GRIZZLY** (Reg. Nos. 2,166,833 and 2,413,625, O/P PUCEL TR. EXH. 9, 11) and one (1) is for the word mark **GRIZZLY INDUSTRIAL** (Reg. No. 2,312,226, O/P PUCEL TR. EXH. 10).

The goods and services recited by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL are identified in the application to register **GRIZZLY.COM** ( O/P PUCEL TR. EXH 7) and in the registrations.

OPPOSER-PETITIONER PUCEL timely opposed registration of **GRIZZLY.COM** (Serial No. 76088346) (O/P PUCEL TR. EXH. 7) on the ground that for many years prior to APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S filing and alleged first use of the service mark, OPPOSER-PETITIONER PUCEL has been engaged in the identical services, manufacture, distribution and sale of the identical products identified by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL in its application to register. OPPOSER-PETITIONER PUCEL has been and is engaged in exactly the same services and goods defined in the application to register GRIZZLY.COM (Serial No. 76088346).

OPPOSER-PETITIONER PUCEL has been engaged in the identical services, manufacture, distribution and sale of material handling and industrial equipment products under its registered trademark **GRIZZLY**® and the **GRIZZLY BEAR**® symbol for many years prior to APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S alleged use of the mark and the filing of its application to register **GRIZZLY.COM**. OPPOSER-PETITIONER PUCEL has been engaged in the identical services, manufacture, distribution and sale of material handling and industrial equipment products under its registered trademark **GRIZZLY**® and the **GRIZZLY BEAR**® symbol for many years prior to APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S alleged use of the marks and the filing of its applications to register which issued as **GRIZZLY** (Reg. Nos. 2,166,833 and 2,413,625, O/P PUCEL TR. EXH. 9, 11) and which issued as **GRIZZLY INDUSTRIAL** (Reg. No. 2,312,226, O/P PUCEL TR. EXH. 10).

Additionally, OPPOSER-PETITIONER PUCEL has sold many additional products not literally specified in its registrations but which are found in its catalogs and price literature. Additionally, accessories to the products illustrated in OPPOSER-PETITIONER PUCEL'S catalog items were identified in the trial testimony of Robert Mlakar.

**In short, OPPOSER-PETITIONER PUCEL AND APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL marks are identical, are used on identical, similar and related goods and services, are sold through identical and similar trade channels to the same and similar customers. These factors weigh heavily in a likelihood of confusion analysis.**

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL began business in 1983 as an importer and at that time was known as GRIZZLY IMPORTS but changed its name to GRIZZLY INDUSTRIAL in 1997 because the word "imports" had a bad connotation. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 22-23) APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL purchased the domain name GRIZZLY.COM from an individual in the San Francisco, California area and the transaction was dated August 18, 1999, nearly two months after the alleged date of first use of the mark in commerce!. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 116, 120; (A/R GRIZZLY INDUSTRIAL EXH. 66).

#### **E. DESCRIPTION OF THE RECORD**

**By agreement of the parties all testimony, exhibits, and documents of whatever kind produced in the instant opposition and cancellation ARE NOT CONFIDENTIAL.** Some documents were filed as confidential documents before the parties agreed to classify all testimony, exhibits and documents as non-confidential.

The evidence of record beyond the pleadings and motions includes:

OPPOSER-PETITIONER PUCEL'S U.S. Trademark Registrations 704,530; 704,631 and 704,588 (O/P PUCEL TR. EXH. 2, 4, 6) all for the **GRIZZLY BEAR**® symbol and U.S. Trademark Registrations 624,055; 704,529, and 704,589 all for the word mark **GRIZZLY**® (O/P PUCEL TR. EXH.

1, 3, 5).

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S application to register the word mark **GRIZZLY.COM** (Serial No. 76/088,346, O/P PUCEL TR. EXH 7).

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S three (3) registrations, two (2) for the word mark **GRIZZLY** (Reg. Nos. 2,166,833 and 2,413,625, O/P PUCEL TR. EXH 9, 11 ) and one (1) for the word mark **GRIZZLY INDUSTRIAL** (Reg. No. 2,312,226, O/P PUCEL TR. EXH.10).

Trial Depositions of OPPOSER-PETITIONER PUCEL include the testimony depositions of Robert Mlakar and Anthony Mlakar taken May 23 and 24, 2006. The trial depositions of Robert Mlakar and Anthony Mlakar refer to OPPOSER'S-PETITIONER'S PUCEL'S trial exhibits. (O/P PUCEL TR. EXH. 1-69).

Discovery depositions of OPPOSER-PETITIONER PUCEL were filed under a notice of reliance by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL and include the discovery depositions of Robert Mlakar and Anthony Mlakar taken March 18, 2003 and include discovery deposition exhibits.

Trial depositions of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL include the testimony depositions of Shiraz Balolia taken on July 18, 2006 and Sidney Levy taken August 31, 2006. The trial depositions of Shiraz Balolia and Sidney Levy refer to APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S trial exhibits. (A/R GRIZZLY INDUSTRIAL EXH.1-67). A/R GRIZZLY INDUSTRIAL EXH. 47, 48 and 49 were objected to when introduced and that objection is maintained.

A discovery deposition of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL was filed under a notice of reliance and includes the discovery deposition of Shiraz Balolia taken November 20, 2002 and includes discovery deposition exhibits.

Third party registrations were filed by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL under a notice of reliance and they are the subject of an objection (i.e., they are objected to). The third party registrations are not evidence of use of the mark that is the subject of the registration and they are

not proof that consumers are familiar with such marks.

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S RESPONSES TO OPPOSER'S FIRST SET OF INTERROGATORIES for each of the consolidated cases were filed by OPPOSER-PETITIONER PUCEL under a notice of reliance.

OPPOSER-PETITIONER PUCEL moved during testimony and again moves for the admission of all evidence introduced and submitted.

#### **F. STATEMENT OF THE ISSUES**

OPPOSER-PETITIONER PUCEL's states the issues as follows:

1. Is APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL entitled to registration of its service mark GRIZZLY.COM (O/P PUCEL TR. EXH.7 ) found in its service mark application to register filed July 10, 2000 under Serial No. 76/088,346 or is there a likelihood of confusion with OPPOSER-PETITIONER PUCEL'S previously used and registered marks, namely, the word mark **GRIZZLY**® (O/P PUCEL TR. EXH. 1, 3, 5) and the **GRIZZLY BEAR**® symbol (O/P PUCEL TR. EXH.2, 4, 6)?

2. Is APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL entitled to registration of its service mark GRIZZLY.COM (O/P PUCEL TR. EXH. 7 ) found in its service mark application to register filed July 10, 2000 under Serial No. 76/088,346 or is there a likelihood of confusion with OPPOSER-PETITIONER PUCEL'S use of the marks, namely, the word mark **GRIZZLY**® (O/P PUCEL TR. EXH. 1, 3, 5) and the **GRIZZLY BEAR**® symbol (O/P PUCEL TR. EXH. 2, 4, 6) for goods and services not specifically recited in OPPOSER-PETITIONER PUCEL'S trademark registrations?

3. Is there a likelihood of confusion between OPPOSER-PETITIONER PUCEL'S previously used and registered marks, namely, the **GRIZZLY BEAR**® symbol and word mark **GRIZZLY**® (O/P PUCEL TR. EXH.1-6) and APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S two (2) registered

marks for the word mark **GRIZZLY** (O/P PUCEL TR. EXH .9, 11) and its one (1) registered mark for the word mark **GRIZZLY INDUSTRIAL** (O/P PUCEL TR. EXH. 10) so as to entitle OPPOSER-PETITIONER PUCEL to cancellation of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S three (3) registered marks (O/P PUCEL TR. EXH. 9, 10, 11)?

4. Is there a likelihood of confusion between OPPOSER-PETITIONER PUCEL'S use of its marks the **GRIZZLY BEAR**® symbol and word mark **GRIZZLY**® for goods and services not specifically recited in its trademark registrations and APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S two (2) registered marks for the word mark **GRIZZLY** (O/P PUCEL TR. EXH 9, 11) and its one (1) registered mark for the word mark **GRIZZLY INDUSTRIAL** (O/P PUCEL TR. EXH. 10) so as to entitle OPPOSER-PETITIONER PUCEL to cancellation of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S three (3) registered marks (O/P PUCEL TR. EXH. 9, 10, 11)?

5. Is there a likelihood of confusion between OPPOSER-PETITIONER PUCEL'S use of the marks **GRIZZLY**® and the **GRIZZLY BEAR**® symbol where both OPPOSER-PETITIONER PUCEL and APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL use the identical marks for the identical goods and services which are sold through the identical channels of trade?

6. Is there a likelihood of confusion between OPPOSER-PETITIONER PUCEL'S use of the marks **GRIZZLY**® and the **GRIZZLY BEAR**® symbol where both OPPOSER-PETITIONER PUCEL and APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL use the identical marks for the identical goods and which are sold to the same customers?

## **G. RECITATION OF FACTS**

### **(1) MARKS OF THE PARTIES**

#### **(a) OPPOSER-PETITIONER PUCEL'S MARKS **GRIZZLY**® AND THE **GRIZZLY BEAR**® SYMBOL**

The marks **GRIZZLY**® and the **GRIZZLY BEAR**® symbol and registrations of OPPOSER-



PETITIONER PUCEL ENTERPRISES are shown on pages 9-11 of this brief. (O/P PUCEL TR. EXH. 1-6;. O/P PUCEL RM TR. DEPO pp 116-126). Additionally, OPPOSER-PETITIONER PUCEL'S marks are shown in its catalogs (O/P PUCEL TR. EXH. 15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30), its price literature (O/P PUCEL TR. EXH. 13, 14), its labels (O/P PUCEL TR. EXH. 17, 18, 31, 32, 33), its invoices (O/P PUCEL TR. EXH. 34, 37), catalogs of its distributors (O/P PUCEL TR. EXH. 54, 56, 57, 58), its internet website (O/P PUCEL TR. EXH. 38, 38A, 61) and the internet website of its distributors (O/P 60). It will be noticed that in some of the usages of OPPOSER-PETITIONER PUCEL'S mark **GRIZZLY**® that it is presented in block form (O/P PUCEL TR. EXH. 30, 60, 38A (GRIZC 09929)).

Robert Mlakar testified that the mark **GRIZZLY.COM** set forth in the application to register is confusingly similar to OPPOSER-PETITIONER PUCEL'S mark **GRIZZLY**® and the **GRIZZLY BEAR**® **SYMBOL** because you can see "it's exactly Grizzly" and "[w]hen you pronounce it, it's pronounced the same, Grizzly. In looking at what they're selling, it's identical to what we sell." (O/P PUCEL RM TR. DEPO pp 111). Further, Mr. Mlakar testified that the mark **GRIZZLY.COM** is exactly the same as OPPOSER-PETITIONER PUCEL'S **GRIZZLY BEAR**® symbol because it creates the identical connotation and meaning.

OPPOSER-PETITIONER PUCEL uses **GRIZZLY**® as a tradename, on products, paperwork and envelopes. (O/P PUCEL RM TR. DEPO pp 162). All products have been marked with **GRIZZLY**® (O/P PUCEL TR. DEPO pp-15, 18, 19)

**(b) APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S MARKS**

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL has presented its marks in its application to register and registrations in BLOCK TYPED form, to wit:

**GRIZZLY.COM**, application to register (O/P PUCEL TR. EXH. 7)

**GRIZZLY**, U.S. Trademark Registration No. 3,413,625 (O/P PUCEL TR. EXH. 9)

**GRIZZLY INDUSTRIAL**, U.S. Trademark Registration No. 2,312,226 (O/P PUCEL TR. EXH. 10)

**GRIZZLY**, U.S. Trademark Registration No. 2,166,833 (O/P PUCEL TR. EXH. 11).

(2) CORRELATION OF THE **GRIZZLY**® AND **GRIZZLY BEAR SYMBOL**® REGISTRATIONS AND OTHER GOODS AND SERVICES OF OPPOSER-PETITIONER PUCEL TO THE APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S APPLICATION TO REGISTER **GRIZZLY.COM**, **GRIZZLY**® AND **GRIZZLY INDUSTRIAL**®

OPPOSER-PETITIONER PUCEL, was formed in 1949 to manufacture and sell material handling equipment and industrial equipment. (O/P PUCEL RM TR. DEPO pp 21). OPPOSER-PETITIONER PUCEL employs about 50 people and employment has been steady over the last 20 years. The industrial equipment which OPPOSER-PETITIONER PUCEL sells includes stands and supports for machine tools. The machines can be any type of machine.

OPPOSER-PETITIONER PUCEL produces welded, heavy duty equipment sold and marketed under **GRIZZLY**® and **GRIZZLY BEAR symbol**® and when inferior light weight products are sold under the **GRIZZLY.COM** mark it hurts business. (O/P PUCEL RM TR. DEPO pp 223).

OPPOSER PETITIONER PUCEL'S brochures are titled GRIZZLY Steel Shop Equipment, GRIZZLY Equipment for Many Uses, GRIZZLY Material Handling and Industrial Equipment, GRIZZLY MANUFACTURER OF MATERIAL HANDLING AND INDUSTRIAL EQUIPMENT. (O/P PUCEL TR. EXH. 15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 197-234). The brochures indicate the following products which are sold and offered for sale on-line through OPPOSER-PETITIONER PUCEL'S internet site. (O/P PUCEL TR. EXH. 38, 38A, 38B, 60)

The equipment identified in the OPPOSER-PETITIONER PUCEL'S 1999 catalog (O/P PUCEL TR. EXH. 30) includes benches including but not limited to welding, molding, tool cabinet, cabinet benches, portable and stationary drawer cabinet benches, various accessories, i.e. drawers, risers, shelves and tops; cabinets including but not limited to storage cabinets of various configurations and designs

such as shelf, wardrobe, bin, tool, wall, lockers, sliding door, bi-fold door; carts including but not limited to box, cleaning, expanded metal, hand, tote-all, hopper, stock, ladder, 3 sided and utility; trucks including but not limited to a-frame, bar & rod, hand, rollover, box, instrument, drum dollies, pan & tray, platform, sheet & panel, shelf trucks, slat top, garment, corner shoes, cradle, and accessories; desks including but not limited to shop & foreman desks of various configurations and styles; drum handling including but not limited to cradles, dollies, racks and lifters; racks including but not limited to die, rack-u-frame, vertical bar, drum stacking of various designs and styles; stands including but not limited to machine cabinet, tool; tables including but not limited to hydraulic lift, marking, utility, portable writing; portable assembly stools; work stations, portable and stationary, ergonomic, with various accessories.

Mr. Mlakar testified at trial that he generated a list of products and services that OPPOSER-PETITIONER PUCEL produces and that list is used by people searching the internet. (O/P PUCEL TR. EXH. 38A; O/P PUCEL RM TR. DEPO pp 130-131). It will be noted from the list generated by Mr. Mlakar that the industries into which the products are sold are extensive and diverse.

OPPOSER-PETITIONER PUCEL'S goods also include all of the goods recited in its six U.S. Trademark Registrations identified above and reproduced hereinabove at pages 8-10. (O/P PUCEL TR. EXH. 1-6).

OPPOSER-PETITIONER PUCEL introduced and submitted United States Trademark Registrations into evidence during trial and are reproduced herein above on pages 8-10. (O/P PUCEL TR. EXH. 1-6 ; O/P PUCEL RM TR. DEPO pp 116, 120, 121, 123, 124, 125) . Additionally, OPPOSER-PETITIONER PUCEL introduced and submitted the catalogs of its products which have been distributed. Specifically, 1954, 1960, 1961, 1964, 1967, 1970, 1976, 1978, 1979, 1980, 1981, 1982, 1990 and 1999 catalogs were introduced and submitted into evidence by corresponding sequential exhibits. (O/P PUCEL TR. EXH. 15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30). And, OPPOSER-PETITIONER PUCEL introduced and submitted into evidence its website. (O/P TR. EXH. 38, 38A,

38B)

(a) CORRELATION OF OPPOSER-PETITIONER PUCELS'  
**GRIZZLY**® AND **GRIZZLY BEAR SYMBOL**®  
REGISTRATIONS AND OTHER GOODS AND SERVICES TO  
APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S  
APPLICATION TO REGISTER **GRIZZLY.COM** 76088346

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S United States Trademark Application to register **GRIZZLY.COM** (O/P PUCEL TR. EXH. 7) includes goods recited by OPPOSER-PETITIONER PUCEL's registrations (O/P PUCEL TR. EXH. 1-6; O/P PUCEL RM TR. DEPO pp 204 ).

Many of the goods recited in the application to register, for example, lathes and drill presses, conveniently rest on and are supported by the goods recited in OPPOSER-PETITIONER PUCEL's registrations. OPPOSER-PETITIONER PUCEL's catalogs illustrate the same and/or similar uses of OPPOSER-PETITIONER PUCEL's products over the years from 1953 to the present. (O/P PUCEL TR. EXH. 15 (Z000062) 30 (pg 19); O/P PUCEL RM TR. DEPO pp 204). See O/P PUCEL TR. EXH. 15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30 for the catalogs of OPPOSER-PETITIONER PUCEL over the years. According to Mr. Shiraz Balolia, President of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL, testified at the discovery deposition that "Roller stands can be used in conjunction with table saws, jointers, planers, band saws, milling machines, shavers, drill presses and other machines..." and that they could be used in any type of shop, not just working and metal working shops (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 19, 21). Mr. Balolia further admitted that the same goods (cartons, wood, tools and machines) could be moved on Pucel's equipment as well as GRIZZLY INDUSTRIAL equipment. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 66). At trial Mr. Balolia characterized all of the products in his catalog that all pages before page 370 as woodworking products and that all products after page 370 are metalworking products. (A/R GRIZZLY INDUSTRIAL SB TR. DEPO pp 95) (A/R GRIZZLY INDUSTRIAL EXH. 1). Metalworkers according to Mr. Balolia include Boeing Aerospace one of his well known customers. (A/R GRIZZLY INDUSTRIAL SB TR. DEPO pp

94).

OPPOSER-PETITIONER PUCEL'S catalogs illustrate the same and/or similar uses of OPPOSER-PETITIONER PUCEL's products and marks over the years from 1953 to 1999 and they are the same products and goods recited in the GRIZZLY.COM application to register. (O/P PUCEL TR. EXH. 15 (Z000062) 30 (pg 19); O/P PUCEL RM TR. DEPO pp 195-215). See O/P PUCEL TR. EXH. 15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30 for the catalogs of OPPOSER-PETITIONER PUCEL over the years.

An annotated quotation of the identification of services for the application to register **GRIZZLY.COM** (O/P PUCEL TR. EXH. 7) follows with the **bolded portions** indicating the identical services and goods sold and offered by OPPOSER-PETITIONER PUCEL. The **underlined and bolded** portions indicate the identical goods found and identified in OPPOSER-PETITIONER PUCEL'S trademark registrations for the **GRIZZLY**® word mark and the **GRIZZLY BEAR**® symbol. The bolded portions which are not underlined indicate the goods and services of OPPOSER-PETITIONER PUCEL which have been sold under the **GRIZZLY** word mark and the **GRIZZLY BEAR**® symbol on a common law basis. (O/P PUCEL TR. EXH. 7; O/P PUCEL RM TR. DEPO pp 114).

**GRIZZLY.COM** IC 035. US 100 101 102. G & S: **Retail store services, online retail store services, and mail order services** (O/P PUCEL TR. EXH. 7; O/P PUCEL RM TR. DEPO pp 114, 128) featuring; abrasives; air cleaners; air compressors; air tanks; air tools; angle finders; anti-kickback devices; **anti-vibration mounts** (O/P PUCEL TR. EXH 7, 19 ; O/P PUCEL RM TR. DEPO pp 38, 61-62, 199); auger bits; bearings; belts; benders; bevels; blade stabilizers; bolt cutters; books and plans; buffing compounds; buffing machines; buffing wheels; burrs; **cable ties** (O/P PUCEL TR. EXH. 7; O/P PUCEL RM TR. DEPO pp 39); calipers; cement; center punches; chain hoists; chisels; chucks; **clamps and vises** (O/P PUCEL TR. EXH 7, 30 ; O/P PUCEL RM TR. DEPO pp 40, 82); clamp heads; containers; cordless tools; cut-off wheels; cutters; dial indicators; dies; digital read outs; discs; **dollies** (O/P PUCEL TR. EXH. 3, 4, 7 , 19; O/P PUCEL RM TR. DEPO pp 42) ; dowel cutting saws; dowel pins; **drafting boards** (O/P PUCEL TR. EXH. 7; O/P PUCEL RM TR. DEPO pp 119) ; drill guides; dust collection accessories; dust pans; dust separators; **electric motors** ( O/P PUCEL TR. EXH 7, 30; O/P PUCEL R.M. TR. DEPO 43, 84); end mill holders; end mills; **engine stands** (O/P PUCEL TR. EXH.1, 2, 7 ; O/P PUCEL RM TR. DEPO pp 44, 49) ; feather boards; file card files; filter bags; flexible curves; **gauges** (O/P PUCEL TR. EXH. 7, 19 ; O/P PUCEL RM TR. DEPO pp 50, 200) ; gear puller; gloves; gouges; grinders; grinding wheels; hacksaws; hammers; hand cleaner; hand punches; **hand screws** (O/P PUCEL TR. EXH. 7, 30 ; O/P PUCEL RM TR. DEPO pp 51, 83) ; **hand trucks** (O/P

PUCEL TR. EXH. 3, 4, 7, 19 ; O/P PUCEL RM TR. DEPO pp 52-53, 57, 200) ; hex keys; **hose reels** (O/P PUCEL TR. EXH. 7 ; O/P PUCEL RM TR. DEPO pp 53-54) ; **hoses** (O/P PUCEL TR. EXH.7 ; O/P PUCEL RM TR. DEPO pp 54) ; inserts for toolholders; **jacks** (O/P PUCEL TR. EXH 7; O/P PUCEL RM TR. DEPO pp 55) ; jig saw blades; jointer knives; knee pads; **knobs**; (O/P PUCEL TR. EXH. 7 ; O/P PUCEL RM TR. DEPO pp 56) laminate trimmer; **lathe accessories** (O/P PUCEL TR. EXH 7 ; O/P PUCEL RM TR. DEPO pp 58-61) ; live centers; **machine mounts**; (O/P PUCEL TR. EXH.7 ; O/P PUCEL RM TR. DEPO pp 61-62) magnetic bases; magnetic shims; **magnetic switches** (O/P PUCEL TR. EXH.7 ; O/P PUCEL RM TR. DEPO pp 63) ; mallets; mandrels; mats; micrometers; miter box; miter trimmer; mortiser machine; moulder/plane; moulding head; moulding head knives; multi-spur bits; nail puller; nailers; nails; notches; planer knives; pliers; protractor; **pulleys** (O/P PUCEL TR. EXH 7 ; O/P PUCEL RM TR. DEPO pp 64) ; punches; push sticks; rasps; ratchet kits; remote controller; router pads; **router table** (O/P PUCEL TR. EXH. 1, 2, 7, 19 ; O/P PUCEL RM TR. DEPO pp 66-67, 200) ; routers; rust remover; safes; sanders; sanding boxes; sanding sealer; sandpaper; saw blades; saw stops; saws; scrapers; screw extractors; screw grabs; screwdrivers; screws; security; shovels; **slide tables** (O/P PUCEL TR. EXH.1, 2, 7 ; O/P PUCEL RM TR. DEPO pp 67) ; slip rolls; sockets; spacers; **spindles** (O/P PUCEL TR. EXH 7, 30 ; O/P PUCEL RM TR. DEPO pp 73, 85) ; sprayers; square; stains; staplers; staples; **storage bins** (O/P PUCEL TR. EXH.1, 2, 7; O/P PUCEL RM TR. DEPO pp 67-68) ; **switches** (O/P PUCEL TR. EXH.7, 29, 30; O/P PUCEL RM TR. DEPO pp 85, 87) ; tapping machine; tie down ratchets; tile cutters; tin snips. **tool tables** (O/P PUCEL TR. EXH. 1, 2, 7, 19 ; O/P PUCEL RM TR. DEPO pp 73, 200) ; trammel points; **wagons** (O/P PUCEL TR. EXH 3, 4, 7, 19; O/P PUCEL RM TR. DEPO pp 71, 72, 200) ; welding rod; welding supplies; wood filler; wrenches; battery chargers; clothing; generators; levels; parts washers; pressure washers; sandblasters; saw horses; scaffolding; shop vacuums; **tool boxes** (O/P PUCEL TR. EXH. 1, 2, 7, 19 ; O/P PUCEL RM TR. DEPO pp 74-5, 201) ; **tool organizers**; (O/P PUCEL TR. EXH 1, 2, 7 ; O/P PUCEL RM TR. DEPO pp 76) wheel barrows; cutlery; cutting tools; drill presses; drilling and boring equipment, namely, brad point bits, countersinks, drill bits, extractors, forstner bits, hole saws, plug cutters, quick change bits, reamers, solid carbide bits, spade bits, step drill bits, tapered bits; dust collection systems; fasteners; finishing supplies, namely, brushes, finishes, finishing supplies, spray guns, sprayers; hand tools; hardware, namely, brackets, **bumpers** (O/P PUCEL TR. EXH. 7, 29, 30 ; O/P PUCEL RM TR. DEPO pp 77-78, 86) , door knockers, **drawer pulls** (O/P PUCEL TR. EXH1, 2, 7, 19 ; O/P PUCEL RM TR. DEPO pp 78-79, 201) , **drawer slides**, **hinges** (O/P PUCEL TR. EXH 1, 2, 7, 19, 29 ; O/P PUCEL RM TR. DEPO pp 87, 88, 201) , **lock sets**, **shelf supports** (O/P PUCEL TR. EXH.1, 2, 7 ; O/P PUCEL RM TR. DEPO pp 90, 91) ; jigs, fixtures; machine accessories, namely, arbors, belt pulleys, blade guides, boring heads, bushings and shapers, chuck inserts, chucks, clamping kits, collet attachments, collets, dividing heads, dust hoods, **electric switches** (O/P PUCEL TR. EXH.7 ; O/P PUCEL RM TR. DEPO pp 91, 92) ; face plates, fences, lathe centers, magnetic chucks, milling attachments, miter gauge, mortising attachments, **motors** (O/P PUCEL TR. EXH. 7 ; O/P PUCEL RM TR. DEPO pp 92) , phase converters, power feed, rails, **rotary tables** (O/P PUCEL TR. EXH.1, 2, 7 ; O/P PUCEL RM TR. DEPO pp 92, 118) , rub collars, sanding attachments, sleeves, **sliding tables** (O/P PUCEL TR. EXH.1, 2, 7 ; O/P PUCEL RM TR. DEPO pp 94 , **spindles** (O/P PUCEL TR. EXH.7, 30 ; O/P PUCEL RM TR. DEPO pp 73, 85) , **stands** (O/P PUCEL TR. EXH.1, 2, 7; O/P PUCEL RM TR. DEPO pp 97) , tailstock turrets, **tool holders**, (O/P PUCEL TR. EXH. 7 ; O/P PUCEL RM TR. DEPO pp 98-99) tool post sets, tool rests, V-belts, V-blocks, wings, **material handling equipment** (O/P PUCEL TR. EXH.7, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 99) , **namely, carts** (O/P PUCEL TR. EXH.3, 4, 7, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 99) , **casters and wheels** (O/P PUCEL TR. EXH.3, 4, 7, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 101, 203) , **mobile bases** (O/P PUCEL TR. EXH.3, 4, 7, 16, 19, 20, 21, 22,

23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 102) , **outfeed tables and stands**, (O/P PUCEL TR. EXH.1, 2, 7, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 104) **roller stands** (O/P PUCEL TR. EXH. 1, 2, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 106) , **rollers**, (O/P PUCEL TR. EXH.3, 4, 7 ; O/P PUCEL RM TR. DEPO pp 107) **tables**, (O/P PUCEL TR. EXH.1, 2, 7, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 107-108, 117) **work stands**; (O/P PUCEL TR. EXH. 1, 2, 7, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 109) **measuring tools** (O/P PUCEL TR. EXH. 1, 2,) ; metal stock; metalworking machines; pneumatic tools; power tools; router bits; safety equipment, namely, ear protectors, eye protection, first aid kits, gloves, respirators; shaper cutters. shop accessories, namely, anvils, arbor presses, belt cleaners, dowel centers, glue, glue bottles, glue brushes, laminating, lubricants, moisture meters, pads and mats, power bits, push blocks, saw gauges, sharpening equipment, namely, drill sharpeners, sharpening stone sets, stop blocks, tape, tweezers; optical equipment; hand tools; coffee; tooling equipment, namely, boring bars, center drills, countersinks, cut-off and parting, dovetail cutters, end mills, fly cutters, indexable tooling, inserts, key seats, multi-function tools, rotary burrs, slitting saws, taps and dies, tool bits; welding and cutting machines; wood products, namely, biscuits, detail kits, dowels, edge banding, pins, plugs, veneer; and woodworking machines. FIRST USE: 19990630. FIRST USE IN COMMERCE: 19990630

Mr. Robert Mlakar testified that OPPOSER-PETITIONER PUCEL separately sells anti-vibration mounts, clamps, vises, hand screws, jacks, knobs, machine mounts, tool boxes, bumpers, drawer pulls, drawer slides, and lock sets. O/P PUCEL RM TR. DEPO pp 238-245). All of OPPOSER-PETITIONER PUCEL'S catalogs and websites could be identified in the correlation above for all bolded and underlined goods and services. In other words all of the catalogs could be identified for each item.

(b) CORRELATION OF OPPOSER-PETITIONER'S PUCEL'S  
**GRIZZLY**® AND **GRIZZLY BEAR SYMBOL**®  
 REGISTRATIONS AND OTHER GOODS AND SERVICES  
 TO APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S  
 UNITED STATES TRADEMARK REGISTRATION NO.  
 2,166,833 FOR **GRIZZLY**®

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S United States Trademark Registration No. 2,166,833 (O/P PUCEL TR. EXH. 11) for the mark **GRIZZLY** includes goods recited OPPOSER-PETITIONER PUCEL's registrations (O/P PUCEL TR. EXH. 1-6).

Many of the goods recited in the application to register, for example, lathes and drill presses, conveniently rest on and are supported by the goods listed in OPPOSER-PETITIONER PUCEL's registrations. OPPOSER-PETITIONER PUCEL'S catalogs illustrate the same and/or similar uses of

OPPOSER-PETITIONER PUCEL's products and marks over the years from 1953 to 1999 and they are the same products and goods recited in the GRIZZLY registration. (O/P PUCEL TR. EXH. 15 (Z000062) 30 (pg 19); O/P PUCEL RM TR. DEPO pp 195-215). See O/P PUCEL TR. EXH. 15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30 for the catalogs of OPPOSER-PETITIONER PUCEL over the years.

An annotated quotation of APPLICANT-RESPONDENT'S GRIZZLY INDUSTRIAL'S identification of goods for United States Trademark Registration No. 2,166,833 (O/P PUCEL TR. EXH. 11) for the mark **GRIZZLY** follows with the **bolded portions** indicating the identical services and goods sold and offered by OPPOSER-PETITIONER PUCEL. The underlined and bolded portions indicate the goods identified in OPPOSER-PETITIONER PUCEL'S trademark registrations.

**REGISTRATION NO. 2,166,833:** IC 007. US 013 019 021 023 031 034 035. G & S: **woodworking and metal working machinery** (O/P PUCEL TR. EXH. 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 193) , namely, table saws, jointers, shapers, planers, power feeders, molders, sanders, scroll saws, bandsaws, dust collectors, woodworking lathes, metalworking lathes, drill presses, grinders, buffers, **electric motors for machines** (O/P PUCEL TR. EXH. 3, 4, 11 ; O/P PUCEL RM TR. DEPO pp 194) , milling machines, power hacksaws, arbor presses, sheet metal machines, pneumatic air tools, namely, compressors, wrenches, sanders, die grinders, ratchets, screwdrivers, drills, spray guns, nailers, staplers, hammers, saws punches, grease guns and air brushes, parts washers, cut-off saws, **rotary tables** (O/P PUCEL TR. EXH. 1, 2, 11; O/P PUCEL RM TR. DEPO pp 193) , dividing heads, and parts therefor. FIRST USE: 19830906. FIRST USE IN COMMERCE: 19830906

(c) CORRELATION OF OPPOSER-PETITIONER'S PUCELS'  
**GRIZZLY® AND GRIZZLY BEAR SYMBOL®**  
REGISTRATIONS AND OTHER GOODS AND SERVICES  
TO APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S  
UNITED STATES TRADEMARK REGISTRATION NO.  
2,413,625 FOR THE MARK **GRIZZLY®**

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S United States Trademark Registration No. 2,413,625 (O/P PUCEL TR. EXH. 9) for the mark **GRIZZLY** involved in this proceeding includes goods recited OPPOSER-PETITIONER PUCEL's registrations (O/P PUCEL TR. EXH. 1-6).

Many of the goods recited in the application to register, for example lathes and drill presses,



conveniently rest on and are supported by the goods listed in OPPOSER-PETITIONER PUCEL'S registrations. OPPOSER-PETITIONER PUCEL'S catalogs illustrate the same and/or similar uses of OPPOSER-PETITIONER PUCEL's products and marks over the years from 1953 to 1999 and they are the same products and goods recited in the GRIZZLY registration. (O/P PUCEL TR. EXH. 15 (Z000062) 30 (pg 19); O/P PUCEL RM TR. DEPO pp 195-215).

An annotated quotation of APPLICANT-RESPONDENT'S GRIZZLY INDUSTRIAL'S identification of goods for United States Trademark Registration No. 2,413,625 for the mark **GRIZZLY** follows with the bolded portions indicating the identical services and goods sold and offered by OPPOSER-PETITIONER PUCEL. The underlined and bolded portions indicate the goods identified in OPPOSER-PETITIONER PUCEL'S trademark registrations.

**REGISTRATION NO. 2,413,625:** IC 035. US 100 101 102. G & S: **Mail order services** (O/P PUCEL TR. EXH. 9, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30), featuring abrasives, jigs, air cleaners, air compressors, air compressor accessories, anti-fatigue mats, aprons, back support belts, meat cutting bandsaws, metal cutting bandsaws, wood bandsaws, bandsaw accessories, biscuits, bit systems, blade cleaners, blade stabilizers, books, brad drivers, brad point bit sets, buffing compounds, buffing systems, buffing wheels, carbon paper, center finders, chisels, band clamps, bar clamps, C-clamps, T-clamps, hold-down clamps, pipe clamps, saddle clamps, specialty clamps, cleaners, combination squares, compressors, contact cement contour gauges, countersink sets, dado blades, dead blow hammers, depth stops, dovetail jigs, dowel plugs, doweling jigs, drafting boards, **drawer slides** (O/P PUCEL TR. EXH 1, 2, 9 ; O/P PUCEL RM TR. DEPO pp 242) , drill bits and guides, drill presses, **drill press accessories** (O/P PUCEL TR. EXH. 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30, O/P PUCEL TR. RM TR. DEPO 186), drill sharpeners, dust collectors, dust collection accessories, **electric motors** (O/P PUCEL TR. EXH. 9; O/P PUCEL RM TR. DEPO pp 194) emery clothes, face frame jigs, face plates, featherboards, files, glues, glue brushes, bench grinders, flex shaft grinders, mini grinders, portable grinders, slow speed grinders, universal knife grinders, wide wheel grinders, **grinding stands** (O/P PUCEL TR. EXH. 1, 2, 9 ; O/P PUCEL RM TR. DEPO pp 185, 190) , grinding stones, grinding wheels, hack saw kits, handscrews, **hinges** (O/P PUCEL TR. EXH 1, 2, O/P PUCEL RM TR. DEPO pp 191), hole restorer tools, **hose reels** (O/P PUCEL TR. EXH.9; )O/P PUCEL RM TR. DEPO pp 191, hollow chisel mortisers, jigs and fixtures, jointers, jointer clamp systems, knee pads, knife-setting jigs, wood lathes, metal lathes, **wood lathe accessories** (O/P PUCEL TR. EXH. 9, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30), lathe chucks, levels, lubricants, **magnetic switches** (O/P PUCEL TR. EXH. 9 ; O/P PUCEL RM TR. DEPO pp 186) , magnetizers and demagnetizers, mallets, **marking gauges, measuring tools** (O/P PUCEL TR. EXH. 1, 2 O/P PUCEL RM TR. DEPO pp 187), miter boxes, miter saw work stations, miter trimmers, **mobile bases** (O/P PUCEL TR. EXH. 3, 4; O/P PUCEL RM TR. DEPO pp 102, 189) , moisture meters, mortising attachments, moulding heads and knives, multi-spur bits, nail guns and nails, nail pullers, **paint and stain kits, paint brushes, paint sprayers** (O/P PUCEL TR. EXH.1, 2, 9; O/P PUCEL RM TR. DEPO pp 189)- HVLP, plans, planers, planer knives, planer/moulders, planer

pals, plug cutters, pneumatic tools, power carvers, power feeders, power tools, pressure washers, push blocks, push sticks, rasps, rasp sets, remote controllers, right angle drives, **roller stands** (O/P PUCEL TR. EXH. 1, 2, 9 ; O/P PUCEL RM TR. DEPO pp 106) , rosette cutterheads and cutters, router bits, router bit sets, router pads, router speed controls, **router tables**, (O/P PUCEL TR. EXH.1, 2, 9 ; O/P PUCEL RM TR. DEPO pp66, 107-108, 117) **router table accessories** (O/P PUCEL TR. EXH.1, 2, 9 ; O/P PUCEL RM TR. DEPO pp 107-108) , rub collars, rub bushings, rub spacers, rubber gloves, rust removers, safety equipment, sandblasters, belt sanders, bench sanders, combination sanders, disc sanders, drum sanders, edge sanders, knife belt sanders, spindle sanders, sanding accessories, sanding belts, sanding discs, sanding drums, sanding rolls, sanding sleeves, sanding wheels, saw blades, bandsaw saw blades, circular saw blades, scroll saw blades, saw horse brackets, saw horses, scaffolding, scrapers, screws, screw accessories, scroll saws, shapers, shaper cutters, sharpening accessories, shop vacuums, snips, spokeshaves, spray guns, staplers, steel squares, step drills, stop blocks, table saws, table saw accessories, table saw inserts, table saw fences, tack cloth, tenon cutters, thickness gauge, toggle clamps, tool organizers, Trammel points, V- belts, varnishes, vise clamps, **vises** (O/P PUCEL TR. EXH.1, 2, 9, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30 ; O/P PUCEL RM TR. DEPO pp 40, 82) , wood parts, wood threading kits, and woodworking accessories, **ordered from printed and on-line catalogs** (O/P PUCEL TR. EXH. 9,16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 114, 128) . FIRST USE: 19831231. FIRST USE IN COMMERCE: 19831231

IC 007. US 013 019 021 023 031 034 035. G & S: **Wood and metal working shop machinery** (O/P PUCEL TR. EXH.16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 114, 128) , namely, air cleaners, air compressors and accessories for air compressors, meat cutting bandsaws, metal cutting bandsaws, wood bandsaws, buffing machines and buffing wheels for metal working, drill presses and **accessories for drill presses** (O/P PUCEL TR. EXH. 1, 2, 3, 4, 9 ; ), dust collectors and accessories for dust collectors, face plates for lathes bench grinders, flex shaft grinders, mini grinders, portable grinders, slow speed grinders, universal knife grinders, wide wheel grinders, **grinding stands** (O/P PUCEL TR. EXH. 1, 2, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 185) , wood lathes and **accessories for wood lathes** (O/P PUCEL TR. EXH. 1, 2, 9,16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30 ; O/P PUCEL RM TR. DEPO pp 186) , lathe chucks, metal lathes and tooling for metal lathes, mortising machines, mortising attachments for drill presses, nail guns, planer knives, belt sanders, bench sanders, combination sanders, disc sanders, drum sanders, edge sanders, knife belt sanders, spindle sanders, sanders and accessories for sanders, sanding belts, sanding discs, sanding drums, sanding rolls, sanding sleeves, sanding wheels, saw blades for power operated saws, bandsaw saw blades, circular saw blades, scroll saw blades, shaper cutters, shop vacuums, steel squares for machines, table saws and **accessories for table saws** (O/P PUCEL TR. EXH. 9, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 186) , milling machines, milling vises for milling machines, **rotary tables** (O/P PUCEL TR. EXH.1, 2, 7 ; O/P PUCEL RM TR. DEPO pp 92, 118) and angle plates for milling machines, sheet metal machines for bending, cutting, notching, slip rolling, and punching flat and tubular sheet metal, sand blasting machines, welding machines, radial drills, and electric and battery operated power tools. FIRST USE: 19831231. FIRST USE IN COMMERCE: 19831231

IC 008. US 023 028 044. G & S: Hand tools, namely, hammers, screwdrivers, chisels, wood carving knives, pliers, scrapers, hand saws, nail pullers, sanding blocks, saw blades, saw horses, socket sets, wrenches, anvils, tap and die sets. FIRST USE: 19831231. FIRST USE IN COMMERCE: 19831231

IC 009. US 021 023 026 036 038. G & S: **Measuring equipment, namely**, (O/P PUCEL TR. EXH. 1, 2, 9 ; O/P PUCEL RM TR. DEPO pp 187) dial indicators, dial calibrators, digital calipers and instruments, and **measuring tapes** (O/P PUCEL TR. EXH. 1, 2, 9; O/P PUCEL RM TR. DEPO pp 187)

; software, namely, software for disseminating information related to wood and metal working and wood and metal working equipment through a global information network; **magnetic switches** (O/P PUCEL TR. EXH. 1, 2, 9 ; O/P PUCEL RM TR. DEPO pp 188) . FIRST USE: 19861231. FIRST USE IN COMMERCE: 19861231

IC 006. US 002 012 013 014 023 025 050. G & S: Nails; steel squares. FIRST USE: 19861231. FIRST USE IN COMMERCE: 19861231

IC 016. US 002 005 022 023 029 037 038 050. G & S: **Paint brushes**. (O/P PUCEL TR. EXH. 1, 2, 9; O/P PUCEL RM TR. DEPO pp 188) FIRST USE: 19831231. FIRST USE IN COMMERCE: 19831231

(d) CORRELATION OF OPPOSER-PETITIONER'S PUCELS'

**GRIZZLY**® AND **GRIZZLY BEAR SYMBOL**®  
REGISTRATIONS AND OTHER GOODS AND SERVICES  
T O APPLICANT-RESPONDENT'S UNITED STATES  
TRADEMARK REGISTRATION NO. 2,312,226 FOR THE  
MARK **GRIZZLY INDUSTRIAL**®

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S United States Trademark Registration No. 2,312,226 (O/P PUCEL TR. EXH. 10) for the mark **GRIZZLY INDUSTRIAL** includes goods recited in OPPOSER-PETITIONER PUCEL's registrations (O/P PUCEL TR. EXH. 1-6.)

During the prosecution of the application to register **GRIZZLY INDUSTRIAL**, APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL disclaimed the word "INDUSTRIAL". Many of the goods recited in the application to register, for example lathes and drill presses, conveniently rest on and are supported by the goods listed in OPPOSER-PETITIONER PUCEL's registrations. OPPOSER-PETITIONER PUCEL'S catalogs illustrate the same and/or similar uses of OPPOSER-PETITIONER PUCEL's products and marks over the years from 1953 to 1999 and they are the same products and goods recited in the GRIZZLY INDUSTRIAL registration. (O/P PUCEL TR. EXH. 15 (Z000062) 30 (pg 19); O/P PUCEL RM TR. DEPO pp 195-215).

An annotated quotation of APPLICANT-RESPONDENT'S GRIZZLY INDUSTRIAL'S identification of goods for the mark **GRIZZLY INDUSTRIAL** follows with the bolded portions indicating the identical services and goods sold and offered by OPPOSER-PETITIONER PUCEL.

**REGISTRATION NO. 2,312,226** IC 007. US 013 019 021 023 031 034 035. G & S: **woodworking and metal working machinery** (O/P PUCEL TR. EXH. 11 ; O/P PUCEL RM TR. DEPO pp 192) namely, table saws; jointers; shapers; planers; power feeders; molders; sanders; scroll saws; bandsaws; dust collection systems comprised of dust collectors, woodworking lathes; metalworking lathes; drill presses; grinders; buffers; **electric motors** (O/P PUCEL TR. EXH. 10 ; O/P PUCEL RM TR. DEPO pp 192) ; milling machines; power hacksaws; arbor presses; sheet metal machines; pneumatic air tools, namely, impact wrenches, ratchet wrenches, grinders, drills, sanders, air brushes, staplers, and nailers; parts washers; cut-off saws; **and parts therefor** (O/P PUCEL TR. EXH. 10 ; O/P PUCEL RM TR. DEPO pp 192) . FIRST USE: 19831231. FIRST USE IN COMMERCE: 19831231

### **(3) CHANNELS OF TRADE**

OPPOSER-PETITIONER PUCEL has current annual sales of about \$5.1 million and spends about \$180,000 per year on advertising. OPPOSER-PETITIONER PUCEL advertises and markets by distributing catalogs, flyers, postcards and brochures which feature its products and a website which shows and features its products. (O/P PUCEL TR. EXH. 38, 38A, 38B, 39, 60 ; O/P PUCEL RM TR. DEPO pp 133; O/P PUCEL AM TR. DEPO pp 13-16, 17, 20-24). Mr. Anthony Mlakar testified that in 1980 OPPOSER-PETITIONER PUCEL advertised in publications, national magazines such as New Equipment Digest, telephone directories, and mailed catalogs.

Mr. Anthony Mlakar testified, and the APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL stipulated to the documents in O/P PUCEL TR. EXH. 41, about a wide variety of advertisements in publications, national magazines, industrial guides, purchasing guides, telephone directories, and catalogs, all bearing the **GRIZZLY®** mark which were distributed regionally, nationally and overseas over several years and long prior to any use by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL. (O/P PUCEL TR. EXH. 41 ; O/P PUCEL AM TR. DEPO pp 30-47).

Catalogs are sent to all of their customers and distributors. (O/P PUCEL RM TR. DEPO pp 205) OPPOSER-PETITIONER PUCEL also sells by mail order. (O/P PUCEL RM TR. DEPO pp 149). OPPOSER-PETITIONER PUCEL sells all of the products identified above in connection with the APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S application to register GRIZZLY.COM on its

website.

OPPOSER-PETITIONER PUCEL'S website identified during the trial testimony of Robert Mlakar provides for ordering online. (O/P PUCEL TR. EXH. 38, pg. GRIZC 10004; O/P PUCEL RM TR. DEPO pp 129, ) Mr. Robert Mlakar testified that OPPOSER-PETITIONER PUCEL has had the website since the late '80s, meaning the late '90s as corrected by his father, Anthony Mlakar, President of Pucel. Mr. Anthony Mlakar testified that OPPOSER-PETITIONER PUCEL began advertising on the internet in 1994, 1995 or 1996. O/P PUCEL AM TR. DEPO pp 18). Mr. Robert Mlakar indicated that the OPPOSER-PETITIONER'S website provides for on-line ordering and identified an order form. All of the products illustrated in the 1999 catalog (O/P PUCEL TR. EXH. 30) appear coextensively on the OPPOSER-PETITIONER PUCEL'S website and all products are evenly sold through the website meaning that sales are spread across product lines on the website (O/P PUCEL TR. EXH. 38; O/P PUCEL RM TR. DEPO pp 129) . Further, Mr. Robert Mlakar, Vice President of OPPOSER-PETITIONER PUCEL testified that the services provided on OPPOSER-PETITIONER PUCEL'S website were identical to the on-line retail store services recited in the application to register GRIZZLY.COM. (O/P PUCEL RM TR. DEPO pp 130). Products are sold from the website all over the United States without geographical constraint. Any individual anywhere can order from the website. (O/P PUCEL RM TR. DEPO pp 206).

OPPOSER-PETITIONER PUCEL also advertises its products in directories, display ads in publications, internet website, catalogs, brochures, flyers and photos. Sales and advertising expenditures per year from the beginning of OPPOSER-PETITIONER PUCEL are set forth in (O/P PUCEL TR. EXH. 39; O/P PUCEL AM TR. DEPO pp 20-23 ).

OPPOSER-PETITIONER PUCEL sells to distributors, dealers, and directly to end users. OPPOSER-PETITIONER PUCEL markets its products through distributors, dealers and end users.

OPPOSER-PETITIONER PUCEL has distributed approximately 15,000 GRIZZLY<sup>®</sup> catalogs each year since the year 2000. (O/P PUCEL TR. EXH. 30 ; O/P PUCEL RM TR. DEPO pp 141) Previously, 20,000 catalogs per year were distributed annually for the 1981, 1982 and 1986 catalogs. (O/P PUCEL AM TR. DEPO pp 16) Equipment, manufactured by OPPOSER-PETITIONER PUCEL, is sold by approximately 2500 outside persons and firms which sell or market products all over the United States and overseas in connection with the GRIZZLY<sup>®</sup> mark. (O/P PUCEL RM TR. DEPO pp 183, 184)

Mr. Robert Mlakar compared the products in the 2001 Grizzly Industrial catalog to OPPOSER-PETITIONER PUCEL'S 1999 GRIZZLY MANUFACTURER OF MATERIAL HANDLING AND INDUSTRIAL EQUIPMENT catalog and found that with few exceptions that APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL is selling all of PUCEL'S products under the **GRIZZLY.COM** mark. (O/P PUCEL TR. EXH. 30, 68 ; O/P PUCEL RM TR. DEPO pp 209-214) Moreover, Mr. Robert Mlakar stated that OPPOSER-PETITIONER PUCEL'S products have remained constant over the years and that the products which appear in OPPOSER-PETITIONER PUCEL'S GRIZZLY EQUIPMENT 1989 and 1964 catalogs are sold by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL under the **GRIZZLY.COM** mark.

Mr. Robert Mlakar further testified that he feels violated in that APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL is using **GRIZZLY.COM** to sell the same products in the same way that OPPOSER-PETITIONER PUCEL sells its products. The fact that APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL has created a new trademark PANTHER for use in its latest 2005 Catalog does not lessen the confusion as indicated by Mr. Robert Mlakar in his testimony. (O/P PUCEL TR. EXH. 30, 68, 69 ; O/P PUCEL RM TR. DEPO pp 216-217).

OPPOSER-PETITIONER PUCEL and others on its behalf advertise and promote **GRIZZLY<sup>®</sup>** Equipment through various websites, various catalogs, distributors, brochures and flyers. Some of the

outside firms include the Thomas Register, Global Equipment, Inc., C & H Distributing, Indoff and Specialized Mail Order (SMO). (O/P PUCEL TR. EXH. 54, 55, 56, 57, 58, 159; O/P PUCEL RM TR. DEPO pp 138-147). The Thomas Register has international exposure and is directed toward engineers, industrial companies, manufacturing companies, machine shops, metal workers, and fabrications shops.

A number of distributors and dealers also promote, advertise and sell GRIZZLY® Equipment, manufactured by OPPOSER-PETITIONER PUCEL. One such distributor is Indoff. (O/P PUCEL TR. EXH. 60 ; O/P PUCEL RM TR. DEPO pp 134, 138). Indoff has salespersons nationally which directly market to end use customers and which distribute their own catalogs.

OPPOSER-PETITIONER PUCEL has a business relationship (advertising relationship) with a company named SPECIAL MAIL ORDER (SMO) which includes the PUCEL products bearing the **GRIZZLY®** and the **GRIZZLY BEAR®** symbol in its catalogs, over one million of which are distributed annually. (O/P PUCEL TR. EXH. 54, 55 ; O/P PUCEL RM TR. DEPO pp 143, 163, 206). OPPOSER-PETITIONER PUCEL has a business relationship with a company named C&H distributing (CH) which includes the PUCEL products bearing the **GRIZZLY®** and the **GRIZZLY BEAR®** symbol in its catalogs. (O/P PUCEL TR. EXH. 56, 57 ; O/P PUCEL RM TR. DEPO pp 144, 145, 164).

It is typical for OPPOSER-PETITIONER PUCEL'S distributors to have websites which are linked to OPPOSER-PETITIONER PUCEL'S websites (O/P PUCEL TR. EXH. 38A, 38B, 59, 60, 61; O/P PUCEL RM TR. DEPO pp 130, 136, 138, 140). These distributors typically use OPPOSER-PETITIONER PUCEL'S registered trademark **GRIZZLY®** and the **GRIZZLY BEAR®** symbol on their websites with the permission of OPPOSER-PETITIONER PUCEL.(O/P PUCEL TR. EXH. 60 ; O/P PUCEL RM TR. DEPO pp 134, 138, 139).

The Thomas Register is linked to the OPPOSER-PETITIONER PUCEL'S website. (O/P PUCEL TR. EXH. 38A ; O/P PUCEL RM TR. DEPO pp 130-131). OPPOSER-PETITIONER PUCEL is the

owner of the URL WWW.PUCEL-GRIZZLY.COM. The Thomas Register is authorized to display the OPPOSER-PETITIONER PUCEL'S registered marks on its website as well. Retail access is enabled by the OPPOSER-PETITIONER PUCEL website where the **GRIZZLY**<sup>®</sup> and the **GRIZZLY BEAR**<sup>®</sup> symbol appear prominently on every page thereof.

Mr. Mlakar testified at trial that he generated a list of products and services that OPPOSER-PETITIONER PUCEL produces and that list is used by people searching the internet. (O/P PUCEL TR. EXH. 38A ; O/P PUCEL RM TR. DEPO pp 130-131). Mr. Robert Mlakar testified at trial that he generated a list of products and services that OPPOSER-PETITIONER PUCEL produces and that list is used by people searching the internet. (O/P PUCEL TR. EXH. 38A ; O/P PUCEL RM TR. DEPO pp 130-131). It will be noted from the list generated by Mr. Mlakar that the industries into which the products are sold are extensive and diverse.

It is further typical for OPPOSER-PETITIONER PUCEL'S distributors to use the trademarks owned by OPPOSER-PETITIONER PUCEL including the word mark **GRIZZLY**<sup>®</sup> and the **GRIZZLY BEAR**<sup>®</sup> symbol (O/P PUCEL TR. EXH. 60; O/P PUCEL RM TR. DEPO pp 138).

Some of OPPOSER-PETITIONER PUCEL's distributors are actually set up with a store front. One of those retailers is Conveyor & Caster in Cleveland, Ohio and the sell to anybody off the street. The internet also provides retail sales to OPPOSER-PETITIONER PUCEL. (O/P PUCEL RM TR. DEPO pp 147).

OPPOSER-PETITIONER PUCEL sells to a variety of customers including metalworkers, woodworkers, plastic workers, automobile workers and electronic workers (O/P PUCEL TR. EXH. 60; O/P PUCEL RM TR. DEPO pp 70, 71, 74-76, 93, 95, 147, 148, 149, 173, 192). OPPOSER-PETITIONER PUCEL sells more than 10% of its sales volume to woodworkers and metalworkers. (O/P PUCEL RM TR. DEPO pp 247).



Mr. Robert Mlakar testified that he "Googled" on OPPOSER-PETITIONER PUCEL'S GRIZZLY<sup>®</sup> MARK AND LOCATED Grizzly Industrial's 2006 catalog and other listings for GRIZZLY. (O/P PUCEL TR. EXH. 62; O/P PUCEL RM TR. DEPO pp 166-168). Mr. Mlakar further testified that consumers would have to go "by chance" and that "there is confusion between the two" in determining which GRIZZLY site to select from the Google listing. Mr. Mlakar testified that if the word is "Grizzly spelled the same Grizzly, sounding the same grizzly and you're looking at it and you see the same type of equipment, it's the same thing. How could that not be confusing? You're looking at Grizzly. You're looking at Grizzly. What is the difference? I don't know." Mr. Mlakar further testified that he had performed internet searching to locate OPPOSER-PETITIONER PUCEL'S website and that he had been led away to GRIZZLY.COM, APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S website.

The pertinent portions of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL's website are illustrated in (O/P PUCEL TR. EXH. 63; O/P PUCEL RM TR. DEPO pp 170-177). OPPOSER-PETITIONER PUCEL sells all of the products sold under the **GRIZZLY.COM** mark which are identified in (O/P PUCEL TR. EXH. 63, 64; O/P PUCEL RM TR. DEPO pp 170-177). Mr. Mlakar testified that OPPOSER-PETITIONER PUCEL sells the exact same products sold by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL in its 2006 catalog. (O/P PUCEL TR. EXH. 65; O/P PUCEL RM TR. DEPO pp 179-181).

#### **(4) PURCHASERS/CONSUMERS OF THE GOODS/SERVICES**

OPPOSER-PETITIONER PUCEL sells to the customers identified as "A SAMPLING OF OUR CUSTOMERS" identified on page 3 of O/P PUCEL TR. EXH. 68, which is the 2005 GRIZZLY INDUSTRIAL CATALOG. For ease of location, O/P PUCEL TR. EXH. 36, is a one page excerpt illustrating the SAMPLING OF CUSTOMERS from 2005. Robert Mlakar testified that OPPOSER-PETITIONER PUCEL sells all of its products to all but about six customers identified in the 2005

GRIZZLY INDUSTRIAL catalog and all but one customer in the 2001 GRIZZLY INDUSTRIAL catalog. (O/P PUCEL TR. EXH. 68, 69; O/P PUCEL RM TR. DEPO pp 150, 153, 160, 250-256). A listing of invoices is found in O/P PUCEL TR. EXH. 37 indicates sales of OPPOSER-PETITIONER PUCEL to the customers identified by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL as "A SAMPLING OF OUR CUSTOMERS" in both the 2001 and 2005 GRIZZLY INDUSTRIAL catalogs. Additional invoices are identified in O/P PUCEL TR. EXH. 34. Mr. Mlakar in his testimony identified and correlated the OPPOSER-PETITIONER PUCEL'S customers and invoices (O/P PUCEL TR. EXH. 34, 37) to the customers of Grizzly Industrial. (O/P PUCEL RM TR DEPO pp 154-163).

Mr. Mlakar testified that OPPOSER-PETITIONER PUCEL sends its catalogs to the customers identified on page 3 of the GRIZZLY INDUSTRIAL catalog. (O/P PUCEL TR. EXH. 68, 69; O/P PUCEL RM TR DEPO 211).

OPPOSER-PETITIONER PUCEL'S customers usually request equipment as "**GRIZZLY®** Equipment" as indicated on its invoices. (O/P PUCEL TR. EXH. 34, 37; O/P PUCEL RM TR. DEPO pp 161). For OPPOSER-PETITIONER PUCEL the average order size is \$500 to \$800 dollars and the sophistication of the customers varies. O/P PUCEL RM TR. DEPO pp 247-248.

OPPOSER-PETITIONER PUCEL'S customers recognize the sturdy welded construction of its products and 99% of the customers are pleased with the products (O/P PUCEL AM TR. DEPO pp 25-28) and as such GRIZZLY® Equipment enjoys a good reputation.

Mr. Shiraz Balolia testified that 15% of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL sales were to metalworkers with 85% directed to woodworkers. When asked about which of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S well known customers are woodworkers or metalworkers he did not know. When asked about whether APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S material handling products were sold to just metalworkers and woodworkers he was not

sure and did not know. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 37-39, 56, 69; A/R GRIZZLY INDUSTRIAL D. DEPO EXH. O/P-4). Mr. Shiraz Balolia further testified that the Pucel's platform trucks, shelf carts can be used to service woodworkers and metalworkers. APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL attributes 50% of its year 2001 sales of \$81,000,000 to its distribution of approximately 1,000,000 catalogs per year, 20-25% of its sales under the **GRIZZLY.COM** website and 15-20% of its sales at its three retail outlets in Washington state, Missouri and Pennsylvania. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 43, 47, 91, 92).

#### **(5) EVIDENCE OF ACTUAL CONFUSION**

OPPOSER-PETITIONER PUCEL has experienced instances of actual confusion as a result of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S use of the **GRIZZLY** mark on its products. (O/P PUCEL TR. EXH. 44; O/P PUCEL AM TR. DEPO pp 47-57). This confusion has run the gamut of OPPOSER-PETITIONER PUCEL's customers seeking to purchase APPLICANT-RESPONDENT's products from it to persons seeking to find APPLICANT-RESPONDENT by mistakenly contacting OPPOSER-PETITIONER PUCEL. Also included in the mistaken contacts are persons attempting to purchase from OPPOSER-PETITIONER PUCEL , products listed in APPLICANT-RESPONDENT's catalog. These instances of actual confusion are evidenced by verbal as well as written communications.

Mr. Anthony Mlakar testified (O/P PUCEL AM TR. DEPO pp 47-57) about instances of actual confusion as follows.

O/P PUCEL TR. EXH. 44 was identified as a catalog request form requisition indicates that the customer from SOMCO PRODUCTS purchased a welding bench from APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL.

O/P PUCEL TR. EXH. 45 was identified as a OPPOSER-PETITIONER PUCEL customer (distributor) seeking a quotation from OPPOSER-PETITIONER PUCEL of equipment sold by

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL.

O/P PUCEL TR. EXH. 46 was identified as correspondence from a distributor of OPPOSER-PETITIONER PUCEL seeking a competitive quotation on a product made by OPPOSER-PETITIONER PUCEL and also sold by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL.

O/P PUCEL TR. EXH. 47 was identified as catalog request form dated October 18, 2000 requisition indicating that the customer from POWER AND RUBBER SUPPLY INC. was looking for APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL.

O/P PUCEL TR. EXH. 48 was identified as a letter dated August 16, 2000 from Industrial Appraisal Company addressed to GRIZZLY EQUIPMENT MFG. BY PUCEL ENTERPRISES INC asking for a quotation of a spindle sander sold by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL.

O/P PUCEL TR. EXH. 49 was identified as a letter from Supply Depot requesting a quotation for products sold by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL dated October 4, 2000.

O/P PUCEL TR. EXH. 50 was identified as a letter from FIND MRO requesting a quotation for products sold by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL.

#### **(6) EVIDENCE OF COPYING**

In Opposition No. 123,136 (O/P PUCEL TR. EXH 8) which was timely filed by OPPOSER-PETITIONER PUCEL against APPLICANT-RESPONDENT seeking to register the mark BEAR POWER. APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL sought to register the mark BEAR POWER for the following goods and services.

**BEAR POWER Goods and Services** (ABANDONED) IC 035. US 100 101 102. G & S: retail store services, online retail store services, and mail order catalogue services featuring material handling and storage items, namely storage cabinets, file cabinets, portable workbenches, machine cabinet stands, heavy duty tool stands, assembly stools, welding benches, workbenches, workbench cabinet units,

workstations, utility tables and carts, mobile tables and carts, hydraulic lift top tables, portable writing tables and carts, box carts, shop tray trucks, hopper tables, stock carts, shop trucks, ladder stock carts, shelf trucks, hand dump trucks, rollover dump trucks, rollover box trucks, box truck, shelf trucks, garment trucks, dolly platform trucks, portable bins and shelf carts, all-purpose hand trucks, drum and can handling equipment, mobile door cabinets, shelving and racks. (O/P PUCEL TR. EXH 8)

The foregoing identification of goods was lifted directly from the OPPOSER-PETITIONER PUCEL'S 1999 product catalog. (O/P PUCEL TR. EXH 30) which was OPPOSER-PETITIONER PUCEL'S 1999 catalog in effect at the time of filing the BEAR POWER trademark application to register.

Mr. Shiraz Balolia testifying in response to a Fed. Rule of Civ. P. 30(b)(6) notice of deposition stated at pages 123-131 of his deposition that APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S attorney prepared the BEAR POWER application and that he, Shiraz Balolia "most probably" provided him with the identification of goods and that there was no one else at the company that might have provided the information to the attorney.

Mr. Balolia then acknowledged that OPPOSER-PETITIONER PUCEL'S 1999 catalog (O/P PUCEL TR. EXH 30) indicates on: page 4 indicates storage cabinets, page 11 indicates filing cabinet desk, page 21 indicates a heavy duty tool stand, page 20 indicate assembly stools, page 20 indicates welding benches, page 22 indicates workbenches, pages 26 to 27 indicate work stations, page 32 indicates utility tables and carts, page 33 indicates mobile tables and carts, page 33 indicates hydraulic lift top tables, page 33 indicates portable writing tables, page 34 indicates box carts, page 34 also indicates shop tray trucks, and page 34 indicates hopper tables. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 123-131, A/R GRIZZLY INDUSTRIAL D. DEPO EXH. O/P-3, O/P-7). These discovery deposition exhibits correspond to OPPOSER-PETITIONER PUCEL'S trial exhibits (O/P PUCEL TR. EXH 30 and 7, respectively).

Finally, Mr. Shiraz Balolia was asked and testified (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 129-130; A/R GRIZZLY INDUSTRIAL D. DEPO EXH. O/P-3, O/P-7) under oath as follows:

"Q. Well, I guess one thing I'm getting at, and we're kind of stuck here on hopper tables, but I think when we go through the rest of these, if we have to, they're exactly in the order that they appear in this catalog [O/P-3] and I just wanted to know how that--how that occurred?  
A. Must be a coincidence"

.....

Q. " Okay. Well let's make sure we get this question straight without any problems. Were --or excuse me. Was the description of goods and services set forth in the Bear Power application, which is part of O/P-7, copied from the Pucel manual?  
A. Not that I can recall."

In fact the evidence shows that the description of the goods found in APPLICANT-RESPONDENT's trademark application for BEAR POWER involved in Opposition No. 123,136 closely and sequentially tracks the list of goods found in OPPOSER-PETITIONER PUCEL's catalog for the year 1999 (O/P PUCEL TR. EXH 30). Robert Mlakar testifying at trial on behalf of OPPOSER-PETITIONER PUCEL confirmed that the 1990 Pucel catalog was copied using the same words in the same order. (O/P R. M. TR. DEPO pp. 127).

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL apparently went through the 1990 Pucel catalog and prepared the identification of the goods for the BEAR POWER application choosing products it wanted to offer under the mark **BEAR POWER** and does offer under **GRIZZLY.COM**.

Further, in connection with the application to register **GRIZZLY.COM**, Mr. Balolia testified that he signed (executed) the application to register with full knowledge that OPPOSER-PETITIONER PUCEL used the word mark **GRIZZLY**® for the exact same goods to which his application to register relates! (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 120-121). Mr. Balolia claims that GRIZZLY is generic.

APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL has quietly encroached closer to the goods and services covered by OPPOSER-PETITIONER PUCEL's common law and registered marks.

## **(7) ENFORCEMENT OF THE MARKS**

**(a) OPPOSER-PETITIONER PUCEL'S ENFORCEMENT**

OPPOSER-PETITIONER PUCEL has actively sought to protect its trademarks. The record reveals OPPOSER-PETITIONER PUCEL's complaint to a company calling itself Grizzly Material Handling Co. in San Antonio, Texas which was using the mark GRIZZLY in 1985. This company refrained from further use of the **GRIZZLY**<sup>®</sup> mark after OPPOSER-PETITIONER PUCEL's complaint. Additionally the record reveals the use of GRIZZLY by Robert M. Slife & Associates, Inc. in 1998. This company refrained from further use of this mark after complaint by OPPOSER-PETITIONER PUCEL. (O/P PUCEL TR. EXH. 52; O/P PUCEL AM TR. DEPO pp 57-58).

In respect to APPLICANT-RESPONDENT, OPPOSER-PETITIONER PUCEL'S OPPOSER-PETITIONER PUCEL initiated contact with APPLICANT-RESPONDENT making complaint about its use of the GRIZZLY mark. These complaints went unresolved which resulted in this proceeding. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 166-168; A/R GRIZZLY INDUSTRIAL D. DEPO EXH 0/P-24)

**(b) APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S ENFORCEMENT**

APPLICANT-RESPONDENT' GRIZZLY INDUSTRIAL'S enforcement of what it believes to be its trademark rights against others can only be characterized as pernicious wherein it has asserted: its Reg. No. 2,413,625 against **GRIZZLY.CAT** for use in connection with business software in Opposition No. 91151996; its Reg. No. 2,413,625 against **GRIZZLY** for use in connection with photography bags; its Reg. No. 2797299 against **GRIZZLY GRIP** for cargo tie-down straps; its Reg. No. 2797299 against **IF YOU'RE GONNA BE A BEAR, BE A GRIZZLY**, for carrying cases for computers; against **GRIZZLY** for replaceable ground engaging tools and wear products used in heavy-duty earth-moving construction and mining machines; against **ELEDYNA GRIZZLY** for electric door bells; electronic door openers; automatic turnstiles; access control and alarm monitoring systems; automated security gates; electric gate operators; its Reg. No. 2166833 against **GRIZZLY** for building materials kit,

primarily consisting of posts, trusses, and lumber all made of wood, windows, hardware and steel sheeting for the construction of a complete building. Additionally, Mr. Shiraz Balolia testified about several other companies which have been the target of Grizzly Industrial's pernicious activities. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 149-158; A/R GRIZZLY INDUSTRIAL D. DEPO EXH 0/P-18)

## **H. LAW AND ARGUMENT**

### **(1) LIKELIHOOD OF CONFUSION**

Likelihood of confusion between marks is properly determined by weighing those factors set out in *In re E. I. du Pont De Nemours & Co.*, 177 USPQ 563, 567 (CCPA 1973) for which there is evidence. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1569, 218 USPQ 390, 394 (Fed. Cir. 1983). A determination of likelihood of confusion is the ultimate legal conclusion based on findings of fact for each pertinent *DuPont* factor considered together.

The weight accorded to an one factor depends on the particular circumstance of the case.

A party has standing to oppose if they have a real interest in the proceeding. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 USPQ 24, 27 (CCPA 1976). Preponderance of the evidence is the standard of proof for a likelihood of confusion. *Cunningham v. Laser Golf. Corp.*, 55 USPQ2d 1845 (Fed. Cir. 2000).

### **(2) MARKS OF THE PARTIES ARE THE SAME**

OPPOSER-PETITIONER PUCEL has used its registered trademarks **GRIZZLY**® and the **GRIZZLY BEAR**® SYMBOL since the inception of OPPOSER-PETITIONER PUCEL in 1949 and has continuously used these marks on its goods since that point in time. (O/P PUCEL TR. EXH.1-6). Opposer's priority is established by its pleaded registration and underlying presumptions of continued use and validity. *MSI Data Corp. v. Microprocessor Systems, Inc.*, 220 USPQ 655, 657-8 (TTAB 1984).

The mark applied for by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL is



**GRIZZLY.COM** (O/P PUCEL TR. EXH 7) and two of the registered marks are for the mark **GRIZZLY** (O/P PUCEL TR. EXH. 9, 11) and the third registered mark is for **GRIZZLY INDUSTRIAL** (O/P PUCEL TR. EXH 10) with the word Industrial disclaimed. Although the registered marks were registered in the late 1990's they allege dates of first use in the early 1980's. The pending application for **GRIZZLY.COM** alleges a date of first use in 1999.

Registrations with typed drawings are not limited to any particular rendition of the mark in comparing the mark. An argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting the mark as a typed drawing, a difference cannot legally be asserted by that party. *Squirtco v. Tomy Corp.*, 216 USPQ 939 (Fed. Cir. 1983). Therefore, OPPOSER-PETITIONER PUCEL'S marks **GRIZZLY**® (O/P PUCEL TR. EXH.1, 3, 5 ) are clearly equivalent and the same as APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL plain block lettering of **GRIZZLY.COM**, **GRIZZLY** and **GRIZZLY INDUSTRIAL**. *MSI Data Corp. v. Microprocessor Systems, Inc.*, 20 USPQ 655, 657-8 (TTAB 1984) (two stylized marks were compared and found to be legally identical).

OPPOSER-PETITIONER PUCEL'S marks are for **GRIZZLY**® (O/P PUCEL TR. EXH.1, 3, 5 ) and for the **GRIZZLY BEAR**® symbol (O/P PUCEL TR. EXH.2, 4, 6 ). The TTAB has held that the two are the legal equivalents, stating: "It is well established that where a mark comprises a representation of an animal or an individual and another consists of the name of the animal or individual such designations are to be regarded as legal equivalents in determining likelihood of confusion. *Squirrel Brand v Green Gables*, 223 USPQ 154 (TTAB 1984).

All of OPPOSER-PETITIONER PUCEL'S six (6) registered marks equate to **GRIZZLY**® and are identical to Applicant's two (2) registered marks and differ from the third registered mark in that this registered mark adds the disclaimed word INDUSTRIAL. APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S mark in its application to register (O/P PUCEL TR. EXH. 7 ) simply adds **.COM** to the

word **GRIZZLY**. All of OPPOSER-PETITIONER PUCEL'S marks and all of Applicant's marks are equivalent.

To the extent that APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL might argue that the marks are not identical in that **INDUSTRIAL** and **.COM** have been added to the word GRIZZLY, OPPOSER-PETITIONER PUCEL strongly urges the disclaimed word **INDUSTRIAL** and the word **.COM** have little or no trademark significance.

*In re CyberFinancial.Net, Inc.*, 65 USPQ2d 1789 (TTAB 2002) and *In re Martin Container, Inc.*, 65 USPQ2d 1058 (TTAB 2002) both stand for the proposition that .COM has no trademark significance. According to the TMEP 1209.03, "[w]hen examining domain name marks, it is important to evaluate the commercial impression of the mark as a whole, including the TLD indicator." The Court of Appeals for the Federal Circuit has cautioned that, while "[t]he addition of a TLD such as '.com' or '.org' to an otherwise unregistrable mark will typically not add any source-identifying significance," this "is not a bright-line, per se rule. In exceptional circumstances, a TLD may render an otherwise descriptive term sufficiently distinctive for trademark registration." *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1177, 71 USPQ2d 1370, 1374 (Fed. Cir. 2004). Such a circumstance is where tennis.net is used as a mark. In the present "typical" situation of use of .COM, however, it is respectfully urged that it has no trademark significance.

It is submitted that in this instance the word **GRIZZLY** is the first and dominant portion of the marks and viewed in their entirety they create exactly the same commercial impressions and contribute to the conclusion that there is a likelihood of confusion between the marks involved herein. See *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 U.S.P.Q. 2d 1895 (TTAB 1988).

The basic rule is that the marks must be compared in their entirety and not dissected. In this case it is submitted that **GRIZZLY** is the dominant feature of all marks. All of the marks have the same appearance and sound and carry the same connotation and commercial impression. It is respectfully

urged that all of the marks equate to **GRIZZLY**. *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

**(a) IDENTICAL MARKS OR NEARLY IDENTICAL MARKS WEIGH HEAVILY IN LIKELIHOOD OF CONFUSION ANALYSIS**

OPPOSER-PETITIONER PUCEL is relying on its registered rights in **GRIZZLY**® and the **GRIZZLY BEAR**® symbol and its use of the marks **GRIZZLY**® and the GRIZZLY BEAR symbol on its full line of goods and services long prior to the APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S application to register **GRIZZLY.COM** and the filing of the two applications to register **GRIZZLY** which issued as Registration Nos. 2,166,833 and 2,413,625 and the filing of the application to register **GRIZZLY INDUSTRIAL** which issued as Registration No. 2,312,226. In, *Otto Roth & Co. v. Universal Corp.*, 209 USPQ 40, 43 (CCPA 1981), the plaintiff relying on an unregistered term to prove likelihood of confusion under Section 2(d) must prove distinctiveness either by inherent distinctiveness or acquired distinctiveness through secondary meaning. OPPOSER-PETITIONER PUCEL has proved distinctiveness and use of its marks long prior to the existence of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL. All products sold have been marked with **GRIZZLY**®, see, generally the entire testimony of Mr. Robert Mlakar and Mr. Anthony Mlakar (O/P PUCEL REM TR. DEPO. pp all; O/P PUCEL AM TR. DEPO pp all).

"It is important to note that the greater the degree of similarity of the marks, the lesser the degree of similarity that is required of the products or services on which they are being used in order to support a holding of likelihood of confusion. *That is, if goods or services are identical or nearly so, confusion may be likely if they are sold or offered for sale under marks which have a lesser degree of similarity. (citations omitted). The opposite is also true. If the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion.*" *In re Concordia International Forwarding Corp*, 222 USPQ 355

(TTAB 1983). (*emphasis ours*); *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992) (degree of similarity between marks declines if marks would appear on virtually identical goods or services); *Han Beauty Inc. v. Alberto-Culver Co.*, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001) (board may focus on dispositive factors, such as similarity of the marks and relatedness of the goods, citing *Dixie Rests*); *In re Dixie Restaurants, Inc.*, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997) (Specific *DuPont* factors may be accorded heavier weight in a given case depending on its facts.); *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB), *aff'd*, 14 USPQ2d 1840 (Fed. Cir. 1990) (a lesser degree of similarity between conflicting marks is required when the mark is applied to identical goods and services; Doubt should be resolved against the newcomer for the newcomer has the opportunity to avoid confusion and is charged with the obligation to do so).

Where the trademark owner and the alleged infringer deal in competing goods or services, the court rarely looks beyond the mark itself. *Fisons Horticulture Inc. v. Vigoro Industries Inc.*, 30 F. 3d 466, 476, 31 USPQ2d 1592, 1596 (3d Cir. 1994) citing *Interpace Corp. v. Lapp*, 721 F.2d 460 (3d Cir. 1983). "The greater the degree of similarity between the applicant's mark and the cited registered mark, the lesser the degree of similarity between the applicant's goods or services and the registrant's goods or services that is required to support a finding of likelihood of confusion . *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001).

It is respectfully urged that where, as here, the registered and common law marks **GRIZZLY**® and **GRIZZLY BEAR**® **SYMBOL** of OPPOSER-PETITIONER PUCEL equate and are substantially identical to the marks of APPLICANT-REGISTRANT GRIZZLY INDUSTRIAL, for which registration is sought and for which registration has been obtained, this *DuPont* factor weighs heavily in favor of a finding of likelihood of confusion.

### **(3) GOODS AND SERVICES OF THE PARTIES ARE THE SAME**

In regard to the goods and services of the application to register **GRIZZLY.COM** (O/P PUCEL TR. EXH 7), there is a direct and identical overlap of the goods recited in the registrations of the

OPPOSER-PETITIONER PUCEL (O/P PUCEL TR. EXH 1-6). They have been **bolded and underlined** in the annotated quotation above. The goods and services which have been **bolded** represent goods and services which have been provided by OPPOSER-PETITIONER PUCEL for many years prior to the filing of the application to register GRIZZLY.COM. **Retail store services, online retail store services, and mail order services** (O/P PUCEL TR. EXH. 7; O/P PUCEL RM TR. DEPO pp 114, 128) are provided by OPPOSER-PETITIONER PUCEL through the internet since the mid 1990's as testified to by Mr. Anthony Mlakar. O/P PUCEL AM TR. DEPO pp 18).

OPPOSER-PETITIONER PUCEL has a website identified during the trial testimony of Robert Mlakar which provides for ordering online. (O/P PUCEL TR. EXH. 38, pg. GRIZC 10004 et seq.; O/P PUCEL RM TR. DEPO pp 129 et seq) It will be noted from the list generated by Mr. Mlakar for use in connection with OPPOSER-PETITIONER PUCEL'S website that the industries into which the products are sold are extensive and diverse. (O/P PUCEL TR. EXH. 38A, 38 ; O/P PUCEL RM TR. DEPO pp 130-131).

Further evidence that the goods recited in the application to register **GRIZZLY.COM**, are coextensive with the goods OPPOSER-PETITIONER PUCEL can be gained from studying the 2001 and 2005 GRIZZLY INDUSTRIAL catalogs (O/P PUCEL TR. EXH. 68, 69) and it is noticed that a considerable portion of the products, for example, lathes and drill presses, conveniently rest on and are supported by the machine stands recited in OPPOSER-PETITIONER PUCEL's registrations. (O/P PUCEL TR. EXH. 68, pgs. 471 et seq.)

OPPOSER-PETITIONER PUCEL's catalogs illustrate the same and/or similar uses of OPPOSER-PETITIONER PUCEL's products over the years since the company began (1953-1999) (O/P PUCEL TR. EXH.15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30; O/P PUCEL RM TR. DEPO pp 197-234) According to Mr. Shiraz Balolia, President of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL, testifying at the discovery deposition that "Roller stands can be used in conjunction with

table saws, jointers, planers, band saws, milling machines, shavers, drill presses and other machines..." and that they could be used in any type of shop, not just woodworking and metal working shops (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 19, 21). Mr. Balolia further admitted that the same goods (cartons, wood, tools and machines) could be moved on Pucel's equipment as well as GRIZZLY INDUSTRIAL equipment. (A/R GRIZZLY INDUSTRIAL SB DISC. DEPO pp 66). These exhibits and this testimony proves that the goods cited in the **GRIZZLY.COM** application to register are one and the same goods identified in OPPOSER-PETITIONER PUCELS REGISTRATIONS.

Mr. Robert Mlakar compared the products in the 2001 Grizzly Industrial catalog to OPPOSER-PETITIONER PUCEL'S 1990 GRIZZLY MANUFACTURER OF MATERIAL HANDLING AND INDUSTRIAL EQUIPMENT catalog and found that with few exceptions that APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL is selling all of the same products under the GRIZZLY.COM mark. (O/P PUCEL TR. EXH. 30, 68 ; O/P PUCEL RM TR. DEPO pp 209-214) Moreover, Mr. Robert Mlakar stated that OPPOSER-PETITIONER PUCEL'S products have remained constant over the years and that the products which appear in OPPOSER-PETITIONER PUCEL'S GRIZZLY EQUIPMENT 1989 and 1964 catalogs are sold by APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL under the GRIZZLY.COM mark. Mr. Shiraz Balolia's discovery testimony ( testifying on behalf of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL) is littered with admissions as to the meaning of the goods identified in the **GRIZZLY.COM** application to register.

The parties offer the exact same services and the exact same goods identified in the application to register **GRIZZLY.COM**! It will be noted that the APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL is proudly using terms such as GRIZZLY GREEN and GRIZZLY BABY ROLLER CABINET SYSTEM in its 2005 GRIZZLY INDUSTRIAL catalog. (O/P PUCEL TR. EXH. 68, pg GRIZC 09548) Where the services and goods are identical as they are here then the degree of similarity in the marks necessary to support a likelihood of confusion declines. *Century 21 Real Estate Corp. v.*

*Century Life of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992).

To the extent that the goods identified in the application are not coextensive with those identified in the OPPOSER-PETITIONER PUCEL'S registrations of its **GRIZZLY**® and **GRIZZLY BEAR**® **SYMBOL** and are not coextensive with the goods sold which do not appear its catalogs and website, the opposition should be sustained. Use of the mark on a wide variety of goods since the beginning of the company has been illustrated. Mr. Anthony Mlakar, president, testified based on his personal knowledge of use of the **GRIZZLY**® and **GRIZZLY BEAR**® **SYMBOL** since 1961 and Mr. Robert Mlakar did the same based on his personal knowledge since 1978.

"It is well established that a 'relatedness' which bespeaks likelihood of confusion may occur not only where goods are involved but can exist between products on the one hand and services dealing with or related to those products on the other hand. (citations omitted) Further, the requisite relatedness may exist even though the products and/or services are not competitive and have significant difference if they could nevertheless come to the attention of the same types of customers under circumstances suggesting a common origin." *MSI Data Corp. v. Microprocessor Systems, Inc.*, 220 USPQ 655, 657-8 (TTAB 1984). Even if there is not a direct overlap in the entirety of the goods and services, the opposition should be sustained as the goods and services are in fact brought to the attention of the same type of customers under circumstances suggesting a common origin.

Additionally, even where the goods are different and diverse likelihood of confusion has been found where an arbitrary mark is used. "While the goods involved may not be competitive or intrinsically related, other factors are present which indicate that appellant's mark resembles appellee K2 Corporation's registered mark, when applied to appellant's goods, to cause confusion. First, appellant's mark and appellee K2 Corporation's mark are identical. Second, appellee K2 Corporation's mark for ski's is arbitrary... Third, the record shows that the involved goods of both parties are advertised in the same magazines. It would not be unusual for consumers, simultaneously confronted with the same arbitrary

mark for intrinsically unrelated goods, to assume a relationship between the sources of the goods."

*Phillip Morris Inc. v. K2 Corp.*, 194 USPQ 81, 82 (CCPA 1977).

All of the above relates equally to the identification of common and related goods and services in **GRIZZLY** United States Trademark Registration No. 2,413,625 (O/P PUCEL TR. EXH. 9) and common and related goods in **GRIZZLY** United States Trademark Registration No. 2,166,833 (O/P PUCEL TR. EXH. 11) and will not be repeated herein. All of the above relates equally to the identification of common and related goods in **GRIZZLY INDUSTRIAL** United States Trademark Registration No. 2,312,226 (O/P PUCEL TR. EXH. 9) and will not be repeated herein.

It is respectfully urged that where, as here, the goods and services used in connection with the marks **GRIZZLY**® and the **GRIZZLY BEAR**® **SYMBOL** of OPPOSER-PETITIONER PUCEL are substantially identical to the goods and services used in connection with the marks **GRIZZLY.COM**, **GRIZZLY** and **GRIZZLY INDUSTRIAL** of APPLICANT-REGISTRANT GRIZZLY INDUSTRIAL, for which registration is sought and for which registration has been obtained, this *DuPont* factor weighs heavily in the favor of a finding of likelihood of confusion.

#### **(4) CHANNELS OF TRADE ARE THE SAME**

None of OPPOSER-PETITIONER PUCEL'S United States Trademark Registrations for **GRIZZLY**® and **GRIZZLY BEAR**® **SYMBOL** (O/P PUCEL TR. EXH. 1-6) are restricted as to channels of trade.

Here, APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL has not restricted its services to any channel of trade in regard to its international class 35 application to register **GRIZZLY.COM** (O/P PUCEL TR. EXH. 7) Nor has APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL restricted its goods and services in United States Trademark Registration No. 2,413,625 (O/P PUCEL TR. EXH. 9) of **GRIZZLY** and has not restricted its goods in United States Trademark Registration No. 2,166,833 (O/P PUCEL TR. EXH. 11) of **GRIZZLY**. Nor has APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL restricted its goods in United States Trademark Registration No. 2,312,226 (O/P PUCEL TR. EXH.10)



of **GRIZZLY INDUSTRIAL**.

To the extent APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL may argue that its applications and registrations are restricted in some way to woodworkers or metalworkers, Mr. Balolia at trial defined woodworking equipment to be everything before page 370 of (A/R GRIZZLY INDUSTRIAL EXH. 1) and metalworking to be everything after page 370. Metalworkers according to Mr. Balolia include Boeing Aerospace one of his well known customers. However, the evidence illustrates that both parties sell to woodworkers and metalworkers. APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL admits that it OPPOSER-PETITIONER PUCEL'S products are usable by woodworkers by their very nature. Further, the evidence indicates that the parties have some of the same customers which are very large companies and governmental institutions. The goods and services of the parties are identical and used in many different industries and settings.

"Where the likelihood of confusion is asserted by an Opposers with respect to a trademark for which an application for registration has been filed, the issue must be resolved on the basis of not only a comparison of the involved marks but also on consideration of the goods named in the application and the **registration**, on consideration of trade and methods of distribution." (emphasis added). *CBS, Inc. v. Morrow*, 218 USPQ 198, 199 (Fed. Cir. 1983). It is respectfully urged that the APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL may not unilaterally declare a restriction to channels of trade covered by OPPOSER-PETITIONER PUCEL'S registration where none exists. *Cunningham v. Laser Golf. Corp.*, 55 USPQ2d 1845, 1848 (Fed. Cir. 2000) (no limitations in the trade channels as defined by the registrations alleged).

Both parties advertise and distribute large number of catalogs to their customers. (O/P PUCEL TR. EXH.15, 16, 19, 20, 21, 22, 23, 24, 25, 26, 28, 27, 29, 30-PUCEL CATALOGS) (O/P PUCEL TR.EXH. 68, 69 GRIZZLY INDUSTRIAL CATALOGS). OPPOSER-PETITIONER PUCEL has distributors which disseminate its catalogs and which publish their own catalogs nationwide which feature **GRIZZLY® EQUIPMENT MFG. BY PUCEL**. OPPOSER-PETITIONER PUCEL advertises

through SMO which distributes over 1,000,000 catalogs per year. Both parties also sell by mail order. Both parties sell through a small number of retail stores where customers come off the street. Opposers needs to only show that the trade channels are of the same type. Opposers does not have to prove that the goods are sold by the same vendor. *Century 21 Real Estate Corp. v. Century Life of Am.*, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Here, the trade channels are of the same type.

It is respectfully urged that where, as here, the channels of trade used in connection with the marks **GRIZZLY**® and **GRIZZLY BEAR**® **SYMBOL** of OPPOSER-PETITIONER PUCEL are substantially identical to the channels of trade used in connection with the marks **GRIZZLY.COM**, **GRIZZLY** and **GRIZZLY INDUSTRIAL** of APPLICANT-REGISTRANT GRIZZLY INDUSTRIAL, for which registration is sought and for which registration has been obtained, this *DuPont* factor weighs heavily in the favor of a finding of likelihood of confusion.

#### **(5) PURCHASERS/CONSUMERS OF THE GOODS/SERVICES ARE THE SAME**

OPPOSER-PETITIONER PUCEL sells to a variety of customers including metalworkers, woodworkers, plastic workers, automobile workers and electronic workers (O/P PUCEL TR. EXH. 60; O/P PUCEL RM TR. DEPO pp 70, 71, 74-76, 93, 95, 147, 148, 149, 173, 192). OPPOSER-PETITIONER PUCEL sells more than 10% of its sales volume to woodworkers and metalworkers. (O/P PUCEL RM TR. DEPO pp 247).

OPPOSER-PETITIONER PUCEL also sells to the exact same customers identified as "A SAMPLING OF OUR CUSTOMERS" identified on page 3 of O/P PUCEL TR. EXH. 68, which is the 2005 GRIZZLY INDUSTRIAL CATALOG. For ease of location, O/P PUCEL TR. EXH. 36, is a one page excerpt illustrating the SAMPLING OF CUSTOMERS from 2005. Robert Mlakar testified that OPPOSER-PETITIONER PUCEL sells all of its products to all but about six customers identified in the 2005 GRIZZLY INDUSTRIAL catalog and all but one customer in the 2001 GRIZZLY INDUSTRIAL catalog. (O/P PUCEL TR. EXH. 68, 69; O/P PUCEL RM TR. DEPO pp 150, 153, 160, 250-256). OPPOSER-PETITIONER PUCEL sends its catalogs to the these common customers.

Mr. Shiraz Balolia testified at trial that the average order size was about \$200 all the way between \$100 up to \$20,000 for purchases from APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL and from their well known customers which are shared with OPPOSER-PETITIONER PUCEL the average order size is \$300-\$400. Mr. Balolia also testified that they use a customer assistance line to help their customers (A/R GRIZZLY INDUSTRIAL SB TR. DEPO pp 75, 76 92, 93). For OPPOSER-PETITIONER PUCEL the average order size is \$500 to \$800 dollars and the sophistication of the customers varies. O/P PUCEL RM TR. DEPO pp 247-248.

The customer sophistication varies according to the testimony of Mr. Robert Mlakar which seems to be consistent with the testimony of Mr. Balolia about customer assistance. Findings of strong similarity in marks and goods tends to outweigh any assertion that APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL may claim that the customers and purchasers of the equipment sold by both parties are too sophisticated to be confused as to the origin of the products and services. *Cunningham v. Laser Golf. Corp.*, 55 USPQ2d 1845, 1848 (Fed. Cir. 2000) citing *HRL Associates, Inc. v. Weiss Associates, Inc.*, 12 USPQ2d 1819 (TTAB 1989), *aff'd*, 14 USPQ2d 1840, 1840-42 (Fed. Cir. 1990); *In re Shell Oil Co.*, 26 USPQ2d 1687 (Fed. Cir. 1993), (Shell argued that Registrant had a relatively small number of customers and that the confusion would be de minimis but the Court did not agree and stated that rights granted under federal registration are not rationed according to the size of the registrant).

Further, it is respectfully urged that where, as here, customers and purchasers of products of both parties place orders of comparable sizes that the customers of the parties are likely to be the same customers. In fact they are.

It is respectfully urged that where, as here, customers and purchasers of products bearing the marks **GRIZZLY**® and **GRIZZLY BEAR**® **SYMBOL** of OPPOSER-PETITIONER PUCEL are the same customers and purchasers of products sold in connection with the marks **GRIZZLY.COM**, **GRIZZLY** and **GRIZZLY INDUSTRIAL** of APPLICANT-REGISTRANT GRIZZLY INDUSTRIAL, for which registration is sought and for which registration has been obtained, this *DuPont* factor weighs

heavily in the favor of a finding of likelihood of confusion.

#### **(6) ACTUAL CONFUSION EXISTS**

The actual confusion in this case has been detailed above. The actual confusion includes misdirected phone calls as well as misdirected quotations from potential customers of each of the parties hereto. The actual confusion has not resulted from carelessness, inattention or indifference. The TTAB has said: "a single instance of confusion is at least illustrative of a situation showing how and why confusion is likely *Molenaar Inc. v Happy Toys, Inc.* 188 USPQ 469 (TTAB 1975). Evidence of actual confusion is entitled to substantial weight as it provides the most compelling evidence of likelihood of confusion" *Lone Star Steakhouse & Saloon v. Alpha of Virginia*, 43 F. 3d 922, 33 USPQ 2d 1481, 1493 (4th Cir. 1995) (further citations omitted). The Court of Appeals for the Third Circuit has observed: Furthermore, even if most of the customers are professionals, the trademark law protects the entire gamut of purchasers, including retail consumers and members of the trade. *Country Floors Inc. v. Gepner*, 18 USPQ 2d 1577 (3d Cir. 1991), Citing *Kroger Grocery & Baking Co. v. Blue Earth Canning Co.*, 88 F.2d 725, 33 USPQ 137, (CCPA 1937).

It is respectfully urged that where, as here, actual confusion between the marks **GRIZZLY**® and **GRIZZLY BEAR**® **SYMBOL** of OPPOSER-PETITIONER and the marks **GRIZZLY.COM**, **GRIZZLY** and **GRIZZLY INDUSTRIAL** of APPLICANT-REGISTRANT GRIZZLY INDUSTRIAL, for which registration is sought and for which registration has been obtained, this *DuPont* factor weighs heavily in the favor of a finding of likelihood of confusion.

#### **(7) COPYING EXISTS**

The Court of Customs and Patent Appeals in deciding a case of likelihood of confusion said: It is well settled that one who adopts a mark similar to the mark of another for closely related goods acts at his peril and any doubt there might be must be resolved against him. *Carlisle Chemical Works v. Hardman & Holden Ltd.* 168 USPQ 11, 112 (CCPA 1970).

Further, where APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL has copied by

"coincidence" the identification of goods using the same terminology and sequence set forth in OPPOSER-PETITIONER PUCEL's 1990 catalog, it becomes apparent that it has done so in bad faith. And, execution of the application to register **GRIZZLY.COM** knowing OPPOSER-PETITIONER PUCEL sold some of the exact same goods under the GRIZZLY® seems also to be in bad faith. Further in the face of the instant proceeding before the Trademark Trial and Appeal Board, APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL has taken the additional inflammatory step of employing **GRIZZLY GREEN** and **GRIZZLY BABY ROLLER CABINET SYSTEM** in its 2005 GRIZZLY INDUSTRIAL catalog. Clearly this conduct is reprehensible and the intent in regard to this action may be presumed. See, *My-T-Fine Corp. v. Samuels*, 21 USPQ 94 (2d Cir. 1934). It is respectfully submitted that this copying factor also weighs heavily in favor of likelihood of confusion.

## **I. SUMMARY**

It is respectfully submitted that OPPOSER-PETITIONER PUCEL has shown a likelihood of confusion. The evidence demonstrates by a preponderance standard that the OPPOSER-PETITIONER PUCEL and APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL's **GRIZZLY**® marks are: identical; are used on identical, similar and related goods and services; are sold through identical and similar trade channels; and, to the same and similar customers.

It is submitted by OPPOSER-PETITIONER PUCEL that the opposition and the petitions for cancellation should be sustained and granted because OPPOSER-PETITIONER PUCEL would be damaged by registration of APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL'S mark for **GRIZZLY.COM** and has been damaged by the three (3) registrations for **GRIZZLY** and **GRIZZLY INDUSTRIAL**. APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL exercised little or no care in adopting its GRIZZLY mark and acted at its peril and the confusion with OPPOSER-PETITIONER PUCEL'S marks should not be countenanced.

No fee is believed due for the filing of this TRIAL BRIEF, however, please charge deposit account 23-3060 if any fee is due in connection with this proceeding.

RESPECTFULLY SUBMITTED,

PUCEL ENTERPRISES, INC.

OPPOSER-PETITIONER PUCEL

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**CERTIFICATE OF SERVICE**

A copy of the above OPPOSER'S-PETITIONER'S (PUCEL'S) TRIAL BRIEF was mailed December 28, 2006 by United States First Class Mail, postage prepaid, to Joseph Schmidt, Esq., Michael Best & Friedrich, Two Prudential Plaza, 180 North Stetson Avenue, Suite 2000, Chicago, Illinois 60601, and was sent via E-Mail to JFSchmidt@michaelbest.com, attorneys for APPLICANT-RESPONDENT GRIZZLY INDUSTRIAL, INC.

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**CERTIFICATE OF FILING**

I hereby certify that this correspondence is being transmitted over ESSTA to the United States Patent and Trademark Office, via the internet, to the URL <http://www.uspto.gov> on December 28, 2006.

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